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In the Supreme Court of the United States.

*Filed Nov. 21, 1898.*

THE UNITED STATES ex rel.  
ALFRED L. BERNARDIN,  
Plaintiff in Error,

vs.

CHARLES H. DUELL, Commis-  
sioner of Patents.

October Term, 1898.  
No. 444.

IN ERROR TO THE COURT OF APPEALS OF THE  
DISTRICT OF COLUMBIA.

BRIEF FOR PLAINTIFF IN ERROR.

JULIAN C. DOWELL,  
GEORGE C. HAZELTON,  
*Attorneys.*

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## STATEMENT OF THE CASE.

The case at bar grows out of an interference proceeding in the Patent Office (under the provisions of Section 4904 of the Revised Statutes) between Alfred L. Bernardin, president and superintendent of the Bernardin Bottle Cap Company, of Evansville, Indiana; William H. Northall, an employee of the Bernardin Company, acting in the interest of the Crown Cork and Seal Company, a corporation of Baltimore, Md., and William Painter, secretary of the latter company; the subject of the controversy being a bottle-sealing device. (Transcript, p. 30.)

The Commissioner of Patents, the Hon. John S. Seymour, decided in favor of Bernardin. (Transcript, pp. 15 and 30-35.) Northall took an appeal to the Court of Appeals of the District of Columbia, under the provisions of Section 9 of the "Act to establish a Court of Appeals for the District of Columbia, and for other purposes," approved

February 9, 1893, and a decision was rendered by that court reversing the decision of the Commissioner. (Transcript, pp. 7, 35 and 37.)

Bernardin being advised that the Court of Appeals had not and could not be clothed with jurisdiction to review on error or appeal the acts of the Commissioner of Patents, he applied to the Commissioner to have him issue the patent to him, said Bernardin, in accordance with his (the Commissioner's) decision, and tendered the final fee, and in all things fully complied with the law in that behalf (Transcript, p. 29), and being refused on the ground that the action of the Court of Appeals was binding on the Commissioner, the relator filed a petition in the Supreme Court of the District of Columbia for a peremptory writ of mandamus, directing the Commissioner of Patents to issue a patent to Bernardin in accordance with his own finding and award, notwithstanding the decision of the Court of Appeals rendered in the appeal from the Commissioner's award. (Transcript, p. 23).

The petition was filed upon the ground that the Court of Appeals was without jurisdiction to entertain the appeal from the Commissioner of Patents. (*Ibid.*, p. 26.)

On the hearing of the appeal in the Interference case from the Commissioner of Patents to the Court the question of the constitutionality of the statute authorizing such appeal was not raised or considered. The question is now presented for the first time.

An alternative writ was issued by the lower court and the answer of the respondent, the Commissioner of Patents, sets forth the facts as they are recited in the petition, but more in detail, so the constitutional question could be squarely raised. (*Ibid.*, p. 28).

The cause coming on to be heard before His Honor, Judge McComas, he denied the petition, and the relator appealed to the Court of Appeals from that decision.

The Court of Appeals, in affirming the judgment of the lower court, said :

"The question, as presented, is one of importance and its rightful determination is a matter of grave doubt. If resolved against the exercise of the jurisdiction there will doubtless be some embarrassing, if not injurious, consequences ; for it has been constantly exercised by the courts of this District since the year 1839, and, of late years especially, many decisions of the courts, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final. **Notwithstanding the grave doubt that we entertain of the soundness of our judgment, we are not convinced that it is our duty to declare against the validity of the statute conferring the jurisdiction.**" (U. S. *ex rel.* Bernardin *vs.* Seymour, 10 App. Cas. D. C., 294.)

Before a writ of error could be sued out from the Supreme Court of the United States, Mr. Commissioner Seymour resigned and his term of office expired, so that Bernardin began action anew against his successor, the Hon. Benjamin Butterworth. This latter case was pending before this honorable Court at the October Term, 1897 (No. 404), but abated before a hearing could be had, by reason of the death of the defendant in error. (Bernardin *vs.* Butterworth, 169 U. S., 600.) Bernardin then renewed the action against the successor of Commissioner Butterworth, the Hon. Charles H. Duell, Commissioner of Patents ; the petition being based upon the same ground as the case of Bernardin *vs.* Seymour, to wit, "that notwithstanding the Act of Congress, approved February the 9th, 1893, *in form* confers jurisdiction upon the Court of Appeals of the District of Columbia to hear an appeal on error prosecuted from the action of the Commissioner of Patents, an officer of the Executive Department of the Government, and to review the official action of said officer of the Executive Department, and to revise and re-

verse or nullify said action, said Statute is, to the extent that it attempts to confer jurisdiction upon the Court of Appeals of the District of Columbia to review, reverse, or nullify the action of the executive branch of the Government, *unconstitutional, inoperative, and void*, and that the said decision rendered and certified in that behalf is *coram non judice*, for want of constitutional authority to entertain, hear, and control by judicial action the official acts of the executive department." (Transcript, pp. 1-6.)

The present case presents the same questions and is based upon the same state of facts as the aforesaid cases of *Bernardin vs. Seymour* and *Bernardin vs. Butterworth*, and by stipulation of counsel parts of the transcript of record in the last-mentioned case have been filed and used as a part of the record in this case. (Transcript, p. 15.)

In the renewed action the case has taken the same course before the Supreme Court of the District of Columbia and the Court of Appeals, as the preceding cases, the latter court having rendered a decision at the October Term, 1898, affirming the judgment of the court below, for the reasons given at length in the opinion of that court delivered in the case of *Bernardin vs. Seymour*, *supra*. (Transcript, p. 60.)

### **ASSIGNMENT OF ERRORS.**

First. The court erred in holding that the Act of Congress conferring the right of appeal to said court, to wit, the Court of Appeals of the District of Columbia, from the decisions of the Commissioner of Patents, an officer of the executive department of the Government, is constitutional.

Second. The court erred in holding that the Act of Congress conferring the right of appeal to said court from the decisions of the Commissioner of Patents, an officer of the

executive department of the Government, does not overstep the boundaries erected by the Constitution between the three great departments of the Government.

Third. The court erred in holding that it has jurisdiction to hear and determine an appeal prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department and to revise or reverse or nullify such action.

Fourth. The court erred in holding that the Act of Congress, approved February 9, 1893, conferring jurisdiction upon the Court of Appeals of the District of Columbia, to hear an appeal in an interference case, prosecuted from the action of the Commissioner of Patents, an officer of the executive department of the Government, and to review the official action of said officer of the executive department, and to revise and reverse or nullify said action, is constitutional.

Fifth. The court erred in holding that it has jurisdiction to entertain appeals from the decisions of an officer of an executive department of the Government, acting within the scope of his departmental jurisdiction, and to revise, modify or annul and practically and in effect review on petition in error on the record the official acts of such officer.

Sixth. The court erred in affirming the judgment of the Supreme Court of the District of Columbia dismissing the petition for a writ of mandamus.

Wherefore, the plaintiff in error, Alfred L. Bernardin, prays that the judgment of the Court of Appeals of the District of Columbia be reversed by this honorable Court, and that the said Court of Appeals be directed by the mandate

of this Court to enter a decree reversing the judgment of the Supreme Court of the District of Columbia and directing that court to issue the writ of mandamus in accordance with the petition.

The main question raised by the record of the case is the constitutionality of the Act of Congress, conferring jurisdiction upon the Court of Appeals of the District of Columbia to entertain and determine appeals from the decisions of the Commissioner of Patents in interference cases. Prior to the Act of Congress, approved February 9, 1893, establishing a Court of Appeals for the District of Columbia, no appeal was allowed from a decision of the Commissioner of Patents in an *interference case*. Section 9 of said Act provides as follows :

"Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the Court of Appeals created by this act; and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

### **The Statutes Conferring the Right of Appeal to the Court.**

The sections of the Revised Statutes conferring this jurisdiction upon the Supreme Court of the District of Columbia, *sitting in banc*, were part of the general act regarding the organization of the Patent Office, passed in 1870, and read as follows :

"Sec. 4911. If such party, except a party to an Interference, is dissatisfied with the decision of the Commissioner, he

may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"Sec. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

"Sec. 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. \* The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

"Sec. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

"Sec. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the

Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

\* \* \* \* \*

"Sec. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes, 'Patents, Trademarks, and Copyrights.'"

It appears from these sections that the jurisdiction now exercised by the Court of Appeals is the same as that formerly exercised by the Supreme Court of the District of Columbia, sitting in banc, except that the Act creating the Court of Appeals provides for an appeal in the case of *Interferences*, which did not exist before the passage of that Act.

The language of section 9, Court of Appeals Act, is that "the determination of appeals from the decision of the Commissioner of Patents *now vested* in the Supreme Court of the District of Columbia, shall be \* \* \* vested in the Court of Appeals."

When, in 1893, the general term of the Supreme Court of the District of Columbia was abolished, and the Court of

Appeals established in its place, the jurisdiction formerly vested in the general term over appeals from the Commissioner of Patents was transferred to the Court of Appeals. Interference cases were added to the appealable cases by a special clause in section 9.

### THE QUESTION.

The question presented here is, will an appeal lie from the Commissioner of Patents to the Court of Appeals in an Interference case to determine the question of priority of invention?

The question is broader than that. It goes to the constitutionality of an Act of Congress providing for an appeal from the Executive Department of the Government to the Judicial; clothing the latter with plenary power on such appeals to review on petition in error the acts of the officials of the Executive Department, and annul them, and compel the official of the Executive Department to obey the direction of the court in that behalf.

The question is raised for the first time in the case at bar, in what is known in the Patent Office as an Interference case.

The patent law provides for Interference proceedings in the Bureau of Patents to determine which of two or more applicants for letters patent is the *first inventor*, and to issue letters patent to such applicant.

The proceeding is instituted in the Patent Office by the Primary Examiner, who declares an Interference, in case two or more parties claim the same invention, and the case is referred to an officer of the Bureau, designated as Examiner of Interferences.

That officer hears the evidence, which is always in the form of depositions, and renders a decision, called an award.

From that decision or award there is an appeal to the

Examiners-in-Chief, and from them to the Commissioner of Patents. The statute in question also provides for an appeal from the Commissioner of Patents to the Court of Appeals of the District of Columbia.

The record of the case is filed with the clerk of the court by the appellant, and the opposing parties are heard on that record.

The statute provides that the only evidence that shall be considered is that which was before the Commissioner of Patents, and that the court shall revise the decision "on the evidence produced before the Commissioner," and that "the revision shall be confined to the points set forth in the reasons of appeal;" in other words, the assignments of error, which must be set forth in the petition filed with the court, and none other.

So the proceeding is in fact and to all intents and purposes a review on petition in error of the finding and decision of the Commissioner of Patents by the Court of Appeals of the District of Columbia.

The proceeding is in no sense one known to the common law, or to any custom or usage which forms a part of our judicial system.

It is a statutory proceeding by which a court of the Judicial Department of the Government sits in judgment to review, revise, reverse or in their discretion nullify, the official acts of the Executive Department, and by the judgment of the reviewing court dominate and control the official action of the Executive Department in the behalf under consideration.

Is this a defensible exercise of jurisdiction by the Court of Appeals? If so, what is the limit to the authority that

may be conferred on the courts to review and annul the acts of the other Departments of the Government? If there is a limit, where is it?

It cannot be successfully contended that the Bureau of Patents, or the Commissioner of that Bureau, forms a part of the Judicial Department of the Government.

Nor can be it successfully contended that the proceeding authorized by the statute is in any sense an appeal from a court of inferior to a court of superior jurisdiction.

Nor will it be successfully urged that the fact that the question determined by the Commissioner of Patents involved the necessity of *hearing evidence and considering the law in deciding the case*, can perforce of that fact confer or tend to confer jurisdiction upon the courts to review that action on error. See *in re Pacific R. Commission*, 32 Fed. Rep., 242, cited hereinafter.

The Patent Office and the Officers of that Bureau are part of the Executive Department.

Possibly the issuance of patents might have been devolved upon any Department of the Government, and the Department clothed with jurisdiction in the premises would exercise that jurisdiction to the exclusion of any supervision by other Departments. But no duty not judicial can be imposed upon the Courts of the United States.

While jurisdiction may be determined by the duties imposed, as in the case of a proceeding against a person for murder; to accuse, try, pronounce sentence and execute the same is in character and quality a judicial proceeding; yet it by no means follows that the fact that *duties* are imposed by an Act of Congress upon the court, that such duties are, perforce of the Act itself, judicial. See *in re Pacific R. Com.*, 32 Fed. Rep., 242.

And it is submitted that because jurisdiction of patent matters might have been conferred upon any one of the Departments of Government, possibly including the Judicial—though issuing a patent is an administrative act—it does not follow that Congress, after conferring jurisdiction upon *one Department*, may give to another Department supervisory jurisdiction over the acts of the Department upon which jurisdiction has been first conferred, so as to enable the former to annul, reverse, or modify the official acts of the latter.

If Congress could so confuse and confound the jurisdiction of the several Departments the independence of each might be wholly dominated by the others, or two by the third.

But the theory and practice of our governmental system was and is to keep and maintain the several Departments of the Government, *i. e.*, the Legislative, Executive, and Judicial, separate, co-equal and independent, each sovereign in its own sphere.

In the case under consideration the Executive Department, by its proper officer in the discharge of the duties cast upon him as an officer of said Department, took certain action. That is to say, the Commissioner of Patents, in the discharge of the duty cast upon him by the law, made suitable and proper investigation to determine who was entitled to have issued to him letters patent for an invention.

He read the evidence and made his award, and thereupon the party against whom the decision or award was rendered proceeded under the statute to prosecute an appeal to the Court of Appeals, as before stated, taking up the record—that is, the evidence introduced before and heard by the Commissioner. The Court reversed the decision of the Commissioner, awarded priority to the appellant, and a certificate under the seal of the Court was forwarded to the Com-

missioner, and it is urged that that decision is binding on the appellee, although it is obvious that the action of the Court, if controlling, ousts the Commissioner of Patents from the exercise of the jurisdiction cast upon him by the statute, and nullifies the law enacted to secure letters patent to those who may, in the judgment of the Commissioner of Patents, be entitled to receive them.

We may remark that in dicta of Mr. Justice Matthews, in the case of *Hoe vs. Butterworth*, Commissioner, hereinafter cited, this jurisdiction is referred to as being *in aid of* the administration of the Patent Office.

But that which controls absolutely and is supreme to order and direct can hardly be properly described as "*in aid of*." And it is expressly decided in the cases of *in re Pac. Ry. Comr.*, 32 Fed Rep., 242, that the courts of the United States will not act in aid of Executive Departments.

Obviously it is not the name of the proceeding, but the quality of the act done in the exercise of the jurisdiction, that will determine its limitation.

This is expressly held in *U. S. vs. Ritchie*, 17 How., page 525.

To call the proceeding one *in aid of* the Executive Department is in fact determining the quality of the act by the name applied to the act, and not by the effect and result of the act.

The consideration of the question we are discussing starts with the fundamental proposition that the three branches of the Government are equal, co-ordinate and independent, and that the maintenance of that equality and separate independence is of the highest concern to the Republic and to the people. And it must follow that one of the most important inquiries is, Does the jurisdiction exercised by the court in the behalf in question militate against that equality and independence? If it does, can it none the less be sustained? If yea, on what ground?

The point we make is :

That the Departments of the Government are co-equal, co-ordinate and independent.

It is the spirit and theory of our Government to keep and maintain them so. And this can only be done by keeping each within its own domain.

But obviously this cannot be so, if the acts of either are subject to review on appeal, and may be annulled by the reviewing authority.

Touching the spirit of the organic law which finds expression in the division of the Government into three co-equal and independent branches, it has been said the idea or policy is as old as Aristotle, who said in discussing the constitution of a State, there are three divisions, the deliberative—in other words, the legislative assembly ; the magistracy, and the judiciary, and this disposition or repository of the powers of the Government was, at that early day, deemed essential to civil liberty.

The relation of the Departments to each other have been considered in several cases.

In the *Sinking Fund* cases, reported in 99 U. S., 718, Justice Waite said :

“One Department of the Government cannot encroach on the domain of another without danger. The safety of our institutions depends in no small degree on the strict observance of this salutary rule.”

Sutherland, in his work on *Statutory Construction*, p. 1, puts the case quite as strong.

He says :

“In the Federal Constitution and in the State Constitutions the three fundamental powers—the legislative, executive and judicial—have been separated, organized in three

distinct departments. This separation is deemed to be of greatest importance, absolutely essential to the existence of a just and free government."

Other cases on this point will be cited later in this brief.

The law—the fundamental law—is emphasized in some of the States by the express language of the Constitution.

The Bill of Rights of New Hampshire, Part I, Article 37, reads as follows :

"In the government of this State the three essential powers thereof, to wit, the legislative, executive and judicial, ought to be kept as separate from and independent of each other as the nature of a free government will admit, or as is consistent with that chain of connection that binds the whole fabric of the Constitution in one indissoluble bond of union and amity."

The Constitution of Massachusetts of 1780, Part I, says :

"Art. XXX. In the government of this Commonwealth the legislative department shall never exercise the executive and judicial powers, or either of them ; the executive shall never exercise the legislative and judicial powers, or either of them ; the judicial shall never exercise the legislative and executive powers, or either of them ; to the end it may be a government of laws and not of men."

The Constitution of Maryland as early as 1776, in its Declaration of Rights, says :

"Art. VI. That the legislative, executive, and judicial powers of the government ought to be forever separate and distinct from each other."

The Constitution of Maryland of 1851, Declaration of Rights, declares :

"Art. VI. That the legislative, executive, and judicial powers of government ought to be forever separate and

distinct from each other, and no person exercising the functions of one of said departments shall assume or discharge the duties of any other."

The Constitution of Virginia, 1776, Declaration of Rights, says :

"Sec. 5. That the legislative and executive powers of the State should be separate and distinct from the judiciary."

The Constitution of Virginia, 1830, expanded that principle in this way :

"Art. II. The legislative, executive, and judicial departments shall be separate and distinct, so that neither exercise the powers properly belonging to either of the others ; nor shall any person exercise the powers of more than one of them at the same time, except that the justices of the county courts shall be eligible to either House of Assembly."

The Constitution of North Carolina, 1776, Declaration of Rights, says :

"Art. IV. The legislative, executive and supreme judicial powers of government ought to be forever separate and distinct from each other."

The Constitution of Georgia, 1798, Article I, says :

"Sec. 1. The legislative, executive and judicial departments of government shall be distinct, and each department shall be confided to a separate body of magistracy ; and no person or collection of persons, being of one of these departments, shall exercise any power properly attached to either of the others, except in the instances herein expressly permitted."

The Constitution of South Carolina, 1868, Article I, says :

"Sec. 26. In the government of this Commonwealth, the legislative, executive, and judicial powers of the govern-

ment shall be forever separate and distinct from each other, and no person or persons exercising the functions of one of said departments shall assume or discharge the duties of any other."

The Constitution of New Jersey, 1844, says.

"Art. III. The powers of the government shall be divided into three distinct departments—the legislative, executive, and judicial—and no person or persons belonging to, or constituting one of these departments, shall exercise any of the powers properly belonging to either of the others, except as herein expressly provided."

The provisions of the several State constitutions in this behalf will be found in "Poore's Charters and Constitutions."

Washington, in his farewell address, dwells on the danger of a disregard of the obligation to observe these limitations of departmental jurisdiction.

As will be observed, in each State of the Union this idea of maintaining the three departments of government separate and independent has been controlling. We cite these numerous references to emphasize the importance of keeping each department within its own domain, and in order that any doubt may not be resolved in favor of sustaining a questionable jurisdiction in the utter absence of necessity therefor.

The supreme importance of keeping the three branches of Government, to wit, the legislative, executive and judicial, separate and distinct, and constraining each to remain within its own domain, was thoroughly discussed when the adoption of the Constitution of the United States was being considered. One of the objections made to the adoption of the Constitution was that sufficient provision was not made in that instrument for a complete and thorough separation of the Departments of Government.

In meeting that objection Madison, Hamilton and Jay, who wrote the several articles for "The Federalist," appreciated the force of the objection and the absolute necessity of keeping these several departments separate and forcing each one as far as may be to remain within its own jurisdiction.

In speaking of that matter in "The Federalist," Vol. I, p. 540, the writer quotes approvingly the language of Montesquieu as follows:

"There is no liberty if the power of judging be not separated from the legislative and executive power."

And further, on p. 334, Vol I:

"The accumulation of all powers—legislative, judicial, and executive—in the same hands, whether one, a few, or many, and whether hereditary, self-appointed or elected, may be justly pronounced the very definition of tyranny."

Reference has been made to the earnest testimony borne by the fathers, and later, law-writers, on the necessity of this utter and thorough separation in the Departments of Government and that neither one should exercise a jurisdiction that properly belongs to the other, nor in anywise needlessly enter its domain.

The difficult question is to determine when the act by one Department, or an officer of one Department, is an encroachment upon the domain of another Department, or is in its essentials the exercise of a jurisdiction which belongs to another Department.

It will be admitted that the functions that properly belong to the executive or administrative department should not be exercised by the judicial, and that those functions which properly belong to the judicial department should not be exercised by the executive or legislative; but the difficulty arises in fixing the boundary line between them,

and the disposition of each department to extend its domain.

It goes without saying that an administrative duty may demand action that is in a sense judicial ; that is, the officer charged with the performance of certain duties may be compelled to exercise the judicial faculty and to hear and determine.

We quote from Field's Federal Courts, Garland's notes, Part I, Chapter I, p. 1 :

"The wisdom of those concerned in framing the Constitution of our government," says the author, "is nowhere more conspicuous than in those provisions of it which relate to the judicial power. They were familiar with the theories of political philosophers as well as the experience of other nations in their efforts to establish free governments, and, with the knowledge derived from these sources they wisely resolved that our government should consist of three departments—legislative, judicial and executive—each having powers to be exercised independent of the other. These elements have been urged as essential to the success of a free government by patriots, statesmen, and speculative philosophers, and it is believed by them, if not generally regarded as a maxim, that these three departments of the Government should be kept separate, distinct and independent of each other."

The political writer Montesquieu had maintained this doctrine with great force and vigor in his Commentary on the English Constitution, and that writer is quoted at considerable length and reasons are given, if reasons were needed, why these powers should be kept separate and distinct, and why neither department should be permitted to encroach upon the domain of the other.

Among other things he says :

"There would be the end of everything were the same man or same body, whether of the nobles or of the people, to

exercise these three powers, that of enacting laws, and in executing the public resolutions, and of trying the causes of individuals."

1st Montesquieu, p. 11, Chap. 6.

Speaking of the exercise of judicial, the necessity of having it co-extensive with the legislative department, Judge Field said :

" If it were otherwise there would be no power to enforce the rights of persons ; there would be no remedy for a violation of these rights."

And Story on the Constitution, Sec. 1574 ; also 1st Kent's Commentaries, 294, says :

" Where there is no judicial department to interpret, pronounce and execute the law, to decide controversies and to enforce rights, the government must either perish by its own imbecility, or the other departments of government must usurp powers for the purpose of commanding obedience to the destruction of liberty."

This subject is discussed in the case of *Kilburn vs. Thompson*, 103 U. S., 168, in which the line of demarkation between the great Departments of the Government is marked out by Justice Miller, speaking for the Court.

Also *Cohens vs. Virginia*, 6th Wheaton, 384.

These cases will be referred to later in this brief.

We deem it well and timely to review more at length the law and authorities bearing on the question raised by the pleadings.

### **Remedy by Bill in Equity.**

It may be urged that the proceeding by bill in equity authorized by Section 4915 is on all fours with the proceeding by appeal from the Commissioner of Patents, but that is not so.

Section 4915 provides a remedy by bill in equity, where an applicant has been refused a patent. It is in no wise and in no sense an appeal from the action of an executive officer, but a separate and independent proceeding, which has nothing to do with the hearing before the Commissioner, but is an independent suit, in which pleadings are filed and testimony taken as in any other suit in equity.

This point has been decided over and over again, so the proceeding by bill in equity furnishes no precedent for proceeding by appeal from the Commissioner of Patents to a court to have the action of the former reviewed by the latter.

By Section 4915 the Circuit Courts of the United States are given a statutory judicial jurisdiction over the class of legal controversies, and the statute conferring such jurisdiction also provides that the findings and decrees of the courts in those cases shall be accepted by the executive department and should authorize the Commissioner to issue a patent to the applicant.

The court decides whether upon the whole case presented complainant is or is not entitled to a patent.

It is not an appeal to a higher tribunal or officer for the review or reversal of the decision of an inferior, but provides an opportunity for an applicant to prove his case in a proceeding *de novo*. (*Gandy vs. Marble*, 122 U. S., 439; *Whipple vs. Miner*, 15 Fed. Rep., 117.)

The jurisdiction sought to be conferred upon the Court of Appeals by the statute in question is of a very different nature.

It takes the case as presented to the Commissioner of Patents, an executive officer, according to the regulations of the Patent Office, and provides for a review of the Commissioner's finding and award upon the same evidence and the reasons upon which he based his decision. It is strictly and expressly a review on petition in error of the Commissioner's decision. The bill in equity, however, is in no sense a review of that decision. Nor does it in law or in fact purport to be. (*Butterworth vs. Hoe*, 112 U. S., 61.)

The appeal to the Court of Appeals is analogous to an appeal from the Secretary of the Treasury to the Supreme Court of the United States upon a question of revenue law, while the provision for a remedy, in equity, is analogous to the payment of a claim by the Secretary of the Treasury after the validity of the claim has been determined by the Court of Claims.

The former would be a direct interference and control by the judiciary with and over the functions and acts of an officer of the Executive Department. The latter is a provision for invoking the assistance of the judicial power and machinery in the investigation and determination of a question judicial in its nature.

The appeal from the Commissioner to the court as provided for in the statute quoted is a plain case of the confusion of executive and judicial functions, and certainly of subordinating the former to the latter.

## **ARGUMENT.**

The granting and issuance of a patent by Government, here and elsewhere is, and always has been, an executive act.

In harmony with the rest of the world the United States has vested this function in the Executive Department, by constituting and organizing the Patent Office, which is a branch of the Interior Department. It was once attached to the State Department, and later made a part of the Interior Department, but it has always been a part of an executive branch of the Government.

Vol. I, Robinson on Patents, p. 76, Section 48.

The Commissioner of Patents acts in an executive capacity in passing upon an application.

The Patent Office is a part of the Executive Department of the Government.

### **Vesting the Duty to Hear Evidence and Determine a Course of Action Thereon Does Not Constitute the Commissioner a Judicial Officer.**

The fact that the discharge of the Commissioner's duties involves the exercise of discretion and of judgment, and even the determination of questions of law and fact upon testimony, does not change the administrative nature of his office and make the duties pertaining to it judicial. The principal function of the Commissioner and of the Patent Office is to determine whether an applicant for a patent is entitled thereto.

This question here presented is not new, though it has not before been raised in the case of an appeal from the Commissioner of Patents.

In *U. S. vs. Ferreira*, 13 Howard, 40, an Act of Congress of 1849 had conferred upon the United States District judge for Florida authority to revise and adjudicate the claims of certain inhabitants against the United States; and an Act of Congress of 1833, under which also they were to act, directed the judges to report their decisions, if in favor of the complainant, to the Secretary of the Treasury, who, being satisfied that the same was just, should pay the amount adjudged.

The court said :

"It is too evident for argument that such a tribunal is not a judicial one. The authority conferred on the respective judges was nothing more than that of a commissioner to adjust claims against the United States. The office of judges and their respective jurisdictions are referred to in the law, merely as designating the person to whom the authority is confided and the territorial limits to which it extends. The decision is not a judgment of a court of justice, it is the award of a Commissioner.

"The powers conferred by these Acts of Congress upon the Judge as well as the Secretary are, it is true, *judicial in their nature*, for judgment and discretion must be exercised by both of them. But it is nothing more than the power ordinarily given by law to a Commissioner appointed to adjust claims to lands or money under a treaty; or special powers to inquire into or decide any other particular class of controversies in which the public or individuals may be concerned. A power of this description may constitutionally be conferred on a Secretary as well as on a Commissioner, but is not judicial in either case in the sense in which judicial power is granted by the Constitution to the Courts of the United States."

In *U. S. vs. Yale Todd*, 13 Howard, 52 note, the court treated of this question. An Act of Congress, I Statute at Large, p. 243, provided that the United States Circuit Courts

should determine the nature of the disability of certain applicants for a pension and the meritoriousness of their claims and report the same to the Secretary of War, together with an opinion upon the amount of a pension each applicant should receive.

This honorable Court held : " That the power proposed to be conferred on the Circuit Court of the United States by the Act of 1792 was not judicial power, within the meaning of the Constitution, and was, therefore, unconstitutional, and could not be lawfully exercised by the courts."

In *Gordon vs. U. S.*, 2 Wall, 561 (opinion given in 117 U. S., 697), Ch. J. Taney says: " Congress may absolutely establish tribunals with special powers to examine testimony and decide in the first instance upon the validity and justice of any claim for money against the United States subject to the supervision and control of Congress or a head of any of the Executive Departments. In this respect the authority of the Court of Claims is like to that of the Auditor or Comptroller, with this difference only, that in the latter case the appropriation is made in advance upon estimates, furnished by the different Executive Departments, of their probable expenses during the ensuing year. \* \* \*

But in principle there is no difference between these two special jurisdictions created by Acts of Congress for special purposes, and **neither of them possess judicial power in the sense in which these words are used in the Constitution.** The circumstance that one is called a court and its decisions called judgments cannot alter its character nor enlarge its powers."

In *People vs. Ulster & Delaware Ry.*, 12 N. Y. Sup., 303, similar pertinent statements were made. In that case a statute providing for the reorganization of railways did not

require the extension of a railroad in case the board of railroad commissioners should, after hearing and determining, certify that the public interests do not require such extension; and further provided, that this certificate should be a bar to any proceedings to compel such an extension, and should be final and conclusive upon all courts, in any proceeding to annul the charter of the corporation for failure to make such extension. It was maintained that this act was unconstitutional, because conferring judicial powers upon an administrative board.

The court said: "Administrative duties often require an administrative officer to decide upon the proper cause of action, and for that purpose to decide what are the facts before him. But he is not, therefore, exercising judicial functions."

In *Hartford Insurance Company vs. Raymond*, 36 N. W. Rep., 474 (Mich.), the Insurance Company as relator sought by mandamus to compel the State insurance commissioner to reverse his decision, and restore to the relator its certificate of compliance with the insurance laws of the State, so that it could carry on its business therein.

It claimed that the authority to grant and revoke, and determine the sufficiency of the cause therefor, by a hearing before him, exercised by the commissioner of insurance was void as an exercise of judicial power by an executive officer, and hence the law vesting that authority in him was unconstitutional.

The court said: "It is claimed that the act is unconstitutional, because it attempts to confer judicial power upon the commissioner of insurance, who is a member of the Executive Department. The power of the Commissioner, however, \* \* \* is but ministerial in its nature and not the exercise of judicial functions."

*In re Kain*, 14 Howard, at 119, Mr. Justice Curtis, speaking of the functions and power of a United States Commissioner, said: "Not only has the law made no provision for the revision of his acts by this court, but strictly speaking, he does not exercise any part of the judicial power of the United States. That power can be exercised only by judges appointed by the President by and with the consent of the Senate, holding their offices during good behavior, and receiving fixed salaries."

Mr. Justice Field said, *in re Pacific Railway Commissioner*, 32 Fed. Rep., 242, at p. 258, when speaking of Hayburn's case:

"Plainly, the power exercised by them (judges) in determining the extent to which invalids were entitled to the pensions provided upon the proof produced was in its nature judicial, for it required an examination of evidence and judgment thereon; but it was not judicial in the sense of the Constitution under which judicial power can be exercised only in the cases enumerated in that instrument."

*In re Pacific Railway Commission*, 32 Fed. Rep., 255, Justice Field, speaking of Sec. 2 of Article III of the Constitution, said:

"As thus modified, the section states all the cases and controversies in which the judicial power of the United States can be exercised, except those arising on a petition for a writ of *habeas corpus*, which is regarded as a suit for one's personal freedom. This judicial power of the United States is therefore vested in the courts, and can only be exercised by them in the cases and controversies enumerated, and in petitions for *habeas corpus*. In no other proceedings can that power be invoked from it and it is not competent for Congress to require its exercise in any other way. Any act providing for such exercise would be a direct invasion of the rights reserved to the States or to the people; and it would be the duty of the court to declare it null and void.

Story says, in his Commentaries on the Constitution, that 'the function of judges of the Courts of the United States are strictly and exclusively judicial. They cannot, therefore, be called upon to advise the President in any executive measure, or to give extrajudicial interpretations of law, or to act as commissioners in cases of pension or other like proceedings.' Section 1777."

It plainly appears from the reasoning of the courts in these decisions that power and authority like that vested in the Commissioner of Patents does not constitute him a judge, or his office a court, in the sense in which those terms are used in the Constitution. The functions of his office are of the same nature as those required of a Commissioner of Internal Revenue. Neither of said officers can properly be regarded a judge. Nor are their duties judicial, though they hear evidence and a high order of judgment and discretion is required of them in estimating values and making proper appraisements, or determining on evidence other questions affecting the rights of persons and property. Both of said offices are executive, as is the office of Commissioner of Patents. The discretion and judgment which any proper system of rating requires, so far as revenue or rate of pension is concerned, is merely incidental to the main purpose of collecting the revenue or deciding what amount shall be allowed and paid as pension.

We submit that neither upon principle nor authority can the Commissioner of Patents be held to be other than an executive officer, or that his quasi-judicial duties are anything more or other than may devolve upon any executive or ministerial officer.

We further submit that appellate jurisdiction over the Commissioner of Patents cannot be constitutionally vested in

the Court of Appeals, for the reason that no duties can be required of that Court that are not judicial, and appeals and writs of error to that Court for review must be from judicial tribunals,—in other words, from courts established by law under the Constitution. And there is not even a pretense that the Commissioner of Patents is a judge, or that his office is a court.

And not only is there a mingling and confusing of the departmental powers of government, but it results in a complete subordination, to the extent that this appellate jurisdiction is exercised by one Department over another; and we may pertinently ask if in the case at bar an appeal for review will lie from the act of the executive officer known and designated by the law as Commissioner of Patents, where is the line of demarkation between those Executive acts which require the exercise of judicial faculties—that is, to hear evidence and pass upon questions affecting rights of property and persons from which an appeal may be prosecuted, and those Executive acts from which *no* appeal may be allowed?

The former cases cannot be limited to those in which official action hinges on conclusions reached after hearing evidence in order to apply the law, for if that was so there would be very few, if any, acts of any one of the Executive Departments which would not be reviewable by the Court on appeal.

It goes without saying that there is not an officer in any branch of the Executive Department who is not required every day to hear evidence and decide what the legal rights of a petitioner or applicant are. But nobody will claim that such officers are judges or that in discharging their duties they act as courts inferior to the Supreme Court.

## **The Constitution Does Not Permit a Confusion of the Powers of Government.**

An appeal to the Court of Appeals from the Commissioner of Patents being limited, as we have already stated, to the evidence as presented to the Commissioner and the reasons for his action, is a confusion of the powers of government which the Constitution does not permit. Obviously the statute in question provides for a review, as upon petition in error, by said Court of the action of this executive officer.

The Constitution contemplates and provides for a complete division and separation of the powers of sovereignty. This is plain from a consideration of the sections apportioning the powers of sovereignty. These sections are as follows :

“ Art. I, Sec. 1. All legislative powers herein granted shall be vested in a Congress of the United States,” &c.

“ Art. II. The executive power shall be vested in a President of the United States of America.”

“ Art. III. The judicial power of the United States shall be vested in one Supreme Court and in such inferior courts as the Congress may from time to time ordain and establish.”

The affirmative words and provisions in these sections are to be taken as exclusive in the interpretation of these sections. When the Constitution says, “ All legislative powers herein granted shall be vested in a Congress,” it disposes of the whole legislative power, and none of it is left to be exercised by either of the other Departments because of peculiar exigency which suggests that such exercise of legislative power would be convenient or useful.

Article II in the same manner makes a complete disposition of the Executive power, and creates the depository of it. It gives the President executive power, and gives him noth-

ing else. All power other than executive conferred upon the President is given him by express provision.

Article III creates and provides for the establishment of courts that shall constitute our judicial system, and vests in those courts the judicial powers of the Government. It gives the Department of the Judiciary the *judicial power* of the Government. No part of the executive or legislative power is conferred upon it. These three articles constitute a brief, concise classification of governmental functions, and the affirmative words are to be taken as exclusive against the grant of other powers.

Cooley, in his *Constitutional Limitations*, 6th Ed., at pp. 104 and 106; Foster on the Constitution, p. 302, sec. 44, and Hare on the Constitution, Vol. I, pp. 173, 174, all support our contention that neither of the three Departments can exercise powers belonging in their nature to either of the others, and that this applies to each Department alike.

Madison, writing in "The Federalist," No. 48, says :

"It is agreed on all sides that the powers properly belonging to one of the Departments ought not to be directly or completely administered by either of the other Departments. It is generally evident that neither of them ought to possess, directly or indirectly, an overruling influence over the others in the respective powers. It will not be denied that power is of an encroaching nature, and that it ought to be effectually restrained from passing the limits assigned to it."

Again, in the same number, he says :

"The conclusion which I am warranted in drawing from these observations is, that a mere demarkation on parchment of the constitutional limits of the several Departments is not sufficient guard against those encroachments which lead to

a tyrannical concentration of all powers of government in the same hands."

Brown on Jurisdiction, pp. 39-41, Sec. 15, after commenting on the distribution of governmental powers, says in conclusion :

"Therefore, **while these co-ordinate branches of the Government are acting within their respective fields, no other power or branch can interfere with their method of acting ; or direct the manner of performing their respective duties, and hence all acts either executive or administrative, legislative or judicial, belonging to the several departments, are independent of the control of the other branches.** Where the duty to be performed embraces administrative legislation or judicial discretion, it is a prerogative right **that the courts cannot control and this rule applies to and is inherent in every member or head of each separate department."**

And again, Sec. 17, pp. 43-44 :

"Courts have no power to compel the Executive Department to enforce the collection of revenue, or to prevent its so doing ; or to dictate the kind, sufficiency, or character of the evidence necessary under an enabling statute to authorize administrative action. They have no control over national boundaries, for it is a purely political question, nor power to give force to a law that is not constitutional, nor to pass upon the justness or policy of a statute that is within legislative jurisdiction—in a word, they have no power to interfere with the action or policy of any other Departments of government."

In *Osborn vs. Bank of U. S.*, 9 Wheat., 255, the court said :

"All governments which are not extremely defective in their organization must possess within themselves the means of expounding as well as enforcing their own laws. If we examine the Constitution of the United States, we find that its framers kept this great political principal in view.

*"The second article vests the whole executive power in the President."*

This honorable Court in *Kilbourn vs. Thompson*, 103 U. S., 190, said :

"It is believed to be one of the chief merits of the American system of written constitutional law, that **all the powers intrusted to government**, whether State or National, **are divided into three grand departments**, the executive, the legislative and the judicial. That the functions appropriate to each of these branches of government shall be vested in a separate body of public servants, and that **the perfection of the system requires that the lines which separate and divide these departments shall be broadly and clearly defined**. It is also essential to the successful working of this system that the **persons intrusted with power in any one of these branches shall not be permitted to encroach upon the powers confided to the others**, but that each shall by the law of its creation be limited to the exercise of the powers appropriate to its own department and no other."

Chief Justice Waite in the *Sinking Fund* cases, 99 U. S., 718, says :

"One branch of the Government cannot encroach on the domain of another without danger. The safety of our institutions depends in no small degree on a strict observance of this salutary rule."

*"They (framers of the Constitution) regarded the independence of the executive hardly less important than that of the judiciary and the legislative, and meant that each department should be a check on the others."*

In *Smith vs. Adams*, 130 U. S., 173, Field, J., speaking of the power of a court to entertain a case concerning the designation of a county seat, said :

"By those terms ('cases and controversies' in Art. III, Sec. II, of the Constitution) are intended claims and conten-

tions of litigants brought before the courts for adjudication by regular proceedings established for the protection or enforcement of rights or the prevention, redress, or punishment of wrongs."

Fontain *vs.* Ravenel, 17 H., 369, is also in point.

The facts were that a testator had died leaving a will in which he made bequests to such charities as should be specified by the executors after the death of his widow. The widow survived the executors, so there was no specification of the charities, and it was desired to have the Circuit Court of United States for Eastern District of Pennsylvania administer the estate and the bequests on the doctrine of *cy pres*. It was held that it could not do so on the ground that such administration was an executive and not a judicial duty, and that the court had only judicial powers and not those executive powers exercised by the English Court of Chancery as the representative of the King.

Taney, C. J.:

"Whether or not the bequest is valid according to Pennsylvania law and would be carried into effect by the courts of that State, yet, United States Court had no jurisdiction. Though English court of chancery would carry into execution a bequest of this kind it would be carried out by the Chancellor as a branch of the prerogative power of the King as *parens patriæ*. The power of the Chancellor over donations to charitable uses so far as it differs from the power he exercises in other cases of trust, does not belong to the court of chancery as a court of equity, nor is it a part of its judicial power and jurisdiction."

"The Constitution declares that the judicial power shall extend, &c. These words obviously confer judicial power and nothing more, and cannot upon any fair construction be held to embrace the prerogative powers which the King as *parens patriæ* in England exercised through the courts.

And the chancery jurisdiction of courts of the United States as granted by the Constitution extends only to cases over which the court of chancery had jurisdiction in its judicial character as a court of equity. The wide discretionary power over infants, idiots and insane or charities exercised by the chancellor of England has not been conferred."

"The Constitution of the United States grants only judicial power at law and in equity to its courts—that is, the powers at that time understood and exercised as judicial in the courts of common law and equity in England. And it must be construed according to the meaning which the words used conveyed at the time of its adoption."

HAYBURN CASE, 2 DALLAS, 409.

This was a motion for a mandamus to the Circuit Court of the District of Pennsylvania, commanding the court to proceed in a certain petition of Hayburn, to be put on the pension list under the statute of March 23, 1792, 1 Statute at Large, 243. The act provided that all disabled officers of the Revolutionary War should be entitled to be placed on the pension list of the United States whom the circuit court of the district in which they resided should think fit, and at the rate recommended by the court, provided that certain rules and regulations were complied with.

The court refused to grant the mandamus at the time of the motion made, and held it over for consideration. In the meantime and before any decision was ever pronounced the matter was disposed of by Congress providing another way for the relief of pensioners in the ascertainment of their rights.

In a note to this case, however, the opinion of the Circuit Court for the District of New York is given as follows :

"That by the Constitution of the United States the government thereof is divided into three distinct and inde-

pendent branches, and that it is the duty of each to abstain from and to oppose encroachments on either; that neither the legislative nor the executive branches can constitutionally assign to the judicial any duties but such as are properly judicial, and to be performed in a judicial manner; that the duties assigned to the circuit courts by this act are not of that description, and that the act itself does not appear to contemplate them as such; inasmuch as it subjects the decisions of these courts, made pursuant to those duties, first to the consideration and suspension of the Secretary of War, and then to the revision of the legislature; whereas by the Constitution, neither the Secretary of War nor any other executive officer, nor even the legislature, are authorized to sit as a court of errors on the judicial acts or opinions of this court.

"As therefore the business assigned to this court, by the act is not judicial, nor directed to be performed judicially, the act can only be considered as appointing commissioners for the purposes mentioned in it, by official instead of personal descriptions; that the judges of this court regard themselves as being the commissioners designated by the act, and therefore as being at liberty to accept or decline that office; that as the objects of this act are exceedingly benevolent, and do real honor to the humanity and justice of Congress; and as the judges desire to manifest, on all proper occasions and in every proper manner their high respect for the National Legislature, they will execute this act in the capacity of commissioners," &c., &c.

U. S. vs. YALE TODD, 13 How., 52, IN NOTE TO FERREIRA CASE.

In this case the question came squarely before the court whether the action of Ch. J. Jay, and Cushing, J., which they took under the act of 1792 mentioned in Hayburn's case and before its repeal, was legal, and it was the unanimous decision of the Supreme Court that it was not, Chief-Justice Jay and Justice Cushing seeming to have changed their minds since the proceedings on the circuit.

"It must be admitted that the justice of the claims and the meritorious character of the claimants would appear to have exercised some influence on their judgments in the first instance, and to have led them to give a construction to the law which its language would hardly justify upon the most liberal rules of interpretation.

The result of the opinions expressed by the judges of the Supreme Court of that day in the note to Hayburn's case, and in the case of the United States *vs.* Todd, is this:

1. That the power proposed to be conferred on the circuit courts of the United States by the act of 1792 was not judicial power within the meaning of the Constitution, and was, therefore, unconstitutional, and could not lawfully be exercised by the courts.

2. That as the act of Congress intended to confer the power on the courts as a judicial function, it could not be construed as an authority to the judges composing the court to exercise the power out of court in the character of commissioners.

3. That money paid under a certificate from persons not authorized by law to give it, might be recovered back by the United States."

*In re Pacific Railway Commission*, 32 Fed. Rep., at p. 254. Field, J., said:

"Be that as it may, the Federal courts cannot, upon that concession, aid the commission in ascertaining how the moneys were expended. Those courts cannot become the instruments of the commission in furthering its investigation. Their power, its nature and extent, is defined by the Constitution. The government established by that instrument is one of delegated powers, supreme in its prescribed sphere, but without authority beyond it. No department of it can exercise any powers not specifically enumerated or necessarily implied in those enumerated. Such is the teaching of all of our great jurists, and the Tenth Amendment declares that 'the powers not delegated to the United States by the Constitution, nor prohibited by it to the States, are reserved to the States respectively, or to the people.' Any legislation of Congress beyond the limits of the powers

delegated is an invasion of the rights reserved to the States or to the people, and is necessarily void. The first Section of the third Article of the Constitution declares that 'the judicial power of the United States shall be vested in one Supreme Court and such inferior courts as Congress may, from time to time, ordain and establish.' "

These views are also confirmed by the constitutions of the States, in all of which the powers of sovereignty are carefully divided and apportioned to appropriate depositories. This is done by different language, most of them using simply the concise division of power used in the Constitution of the United States. In many, however, the division is insured by a clause forbidding the exercise by any one of the powers of either of the others. In New Hampshire, for instance, it is provided that "no person or collection of persons exercising the functions of one department shall assume or discharge the functions of any other." Similar prohibitory sections are found in the constitutions of Massachusetts, Maine, Vermont, New Jersey, Indiana, Illinois, Michigan, Louisiana, Minnesota, Pennsylvania, Maryland, Virginia, West Virginia, Kentucky, Tennessee, Missouri, Alabama, Arkansas, Texas, California, Oregon, Colorado, South Carolina, Georgia, Mississippi, Florida. Other States, however, not having this provision in their constitutions, support the strict division of governmental power.

The decisions under these and other State constitutions are numerous and they uniformly recognize the principle of the separation of the powers of government, regardless of whether that principle is expressly stated in the Constitution. From them we cite the following cases:

IN RE SPLANE, 16 ATL., 481.

Petition for mandamus to compel admission of an attorney to practice law.

Held, to be a judicial act which cannot be compelled by the legislature on certain conditions precedent.

"If there is anything clear in the Constitution, it is that the legislature cannot exercise judicial powers. They are lodged exclusively in the judiciary. The legislative and executive departments can no more encroach upon the judiciary than the latter can encroach upon them."

"Each department in our beautiful system of government has its own appropriate spheres, and so long as it confines itself to its orbit the machinery of government moves without friction. We have too much respect for the legislature to suppose it would ever intentionally step over the line which divides the respective departments, but slight encroachments may sometimes occur by inadvertence. In such cases it is the province of the jury to correct them." Petition dismissed.

**TITUSVILLE IRON WORKS VS. KEYSTONE OIL CO., 15 A, 917 (PA., 1888).**

Act of 1887 directed the courts to hereafter construe the mechanics' lien act so as to extend the lien to all laborers and material men, which was at variance with a long line of decisions.

Held unconstitutional :

"The Legislature can no more exercise judicial powers than the courts can arrogate to themselves legislative powers. The legislative and judicial departments of the Government are independent and co-ordinate.

"The Act of 1887 is in no respect a legislative declaration of rights and privileges of the class of persons to whom it relates, but it is a judicial order or decree directed to the courts. It undertakes to give a new and final interpretation to the Acts of 1836 and 1845 and directs the courts to adopt that interpretation in all cases that may be before them. This is a clear case of the exercise of judicial power by a department that does not possess it."

## TERRITORY VS. STEWART, 23 PAC. REP., 405.

An act of the legislature providing that when a majority of the inhabitants of a town or village present a petition to the district judge, setting forth the area to be included in such village and praying to be incorporated, such judge shall order its incorporation and decide upon its metes and bounds, is unconstitutional for mixing the powers of government.

Held :

"It is with us in America a legislative function to draw the line separating the limits of a place to be incorporated, and the people thereof. (1 Dill Municipal Corporation, Sec. 183, 3d Ed.). \* \* \*

We hold that a judicial court cannot exercise legislative functions and that the legislature cannot impose such power upon it."

GREGG VS. STATE EX REL. W. H. GUDGEL, 94 IND., 384, holds that fixing bail is a judicial act and a clerk of court cannot be vested with the power to do it, because the Constitution in strong terms declares that judicial powers shall be vested in courts and not in ministerial officers.

## TILLMAN VS. COCKE, 68 TENN., 429.

The general rule in Tennessee is that all parties to suits can testify. One statute says, however, that in all actions by or against executors and administrators neither party shall be allowed to testify unless called by the other party or required to do so by the court. Held unconstitutional for vesting courts with legislative powers regarding each particular case.

"This is not to adjudge what the law is but to make it a power which cannot be conferred on the court by the legislature."

See also—

Board of Commissioners *vs.* Gwin, 36 N. E. Rep., 242.

Shaultz *vs.* McPheeters, 79 Ind., 373.

*Re* Sims, 37 Pac. Rep. 135 (Kan., 1894).

Galesburg *vs.* Hawkins, 75 Ill., 152.

This construction of the language of these articles is in harmony with the ideas current at the period of the adoption of the Constitution, with the principles upon which the Constitution was formed.

Chief Justice Taney, in *Gordon vs. U. S.*, said (117 U. S. Rep., at p. 706) when speaking of the acceptance of this principle by the framers of the Constitution :

**"These cardinal principles of free government had not only been long established in England, but also in the United States from the time of their earliest colonization, and guided the American people in framing and adopting the present Constitution. And it is the duty of this Court to maintain it unimpaired as far as it may have the power. And while it executes firmly all the judicial powers entrusted to it, the Court will carefully abstain from exercising any power that is not strictly judicial in its character, and which is not clearly confided to it by the Constitution."**

One of the most important characteristics of the English constitution was the substantial independence of the three departments of governments. It had been secured by centuries of controversy, and was regarded as a precious political heritage.

The independence of Parliament from the King, the limitations set to the royal prerogative and the absolute independence of the judiciary from either was the result of a long and bitter struggle which had cost one sovereign his head.

It was the object of the framers of the Constitution to carry this separation of the powers still farther and to fix this principle firmly in the Constitution.

This appears in their making the heads of executive departments entirely independent of Congress in contradistinction to the English custom which permits cabinet officers to take part in legislative proceedings.

It is plain, then, that it was the object of the framers to firmly fix the principle of the separation of powers of sovereignty in the new government.

This policy of our Government has always been recognized to be in operation in our constitutional jurisprudence from the earliest decisions to the present time. The opinions are as clear in the Sinking Fund cases in 99 U. S. and *Kilbourn vs. Thompson*, 103 U. S., as in *Hayburn's case* in Dallas.

### **An Appeal from the Executive Department to the Judicial Department.**

Mr. Justice Matthews, in *Butterworth vs. Hoe*, 112 U. S., 50, speaks of this proceeding as "in aid of" the proceedings in the Patent Office. This proceeding, however, is not in aid of, but absolutely controls the action in the Patent Office and the result of its proceedings. A proceeding having such an effect cannot be properly said to be merely *in aid of*.

It is exactly what Madison, writing in "The Federalist" (No. 48, which we have quoted elsewhere), was treating of when he said :

"It is agreed on all sides that the powers properly belonging to one of the departments ought not to be directly or completely administered by either of the other departments.

It is generally evident that neither of them ought to possess directly or indirectly an overruling influence over the others in their respective power. It will not be denied that power is of an encroaching nature and that it ought to be effectually restrained from passing the limits assigned to it."

We fortunately have abundance of authorities upon the question of the illegality of such an appeal, and also upon the illegality of making the judiciary such aids to the other departments.

U. S. vs. RITCHIE, 17 HOWARD, 525.

Appeal from a decree from the District Court of California.

The proceedings were originally commenced before the board of commissioners to settle private land claims in California, under the Act of Congress of 1851, March 3rd. The petition was filed before that board by Ritchie against the United States, setting forth a claim to a tract of land known by the name of "Suisun," praying that the title might be confirmed.

The commissioners after hearing the proofs, ordered the title confirmed to claimant.

A transcript of the proceedings before the board with their decision was filed in the U. S. district court. Further testimony was taken and heard by the court, and the decision of the board of commissioners was confirmed.

On appeal from that decree to this Court objection was taken to the jurisdiction of the district court to hear and determine the cause.

The statute under which the appeal was taken provides that a transcript of the proceedings before the Commissioners shall be filed in the district court, and the evidence on which the same was founded, which filing should operate as an appeal.

The Court said (*italics ours*):

"It is also objected, that the law prescribing an appeal to the district court from the decision of the board of commissioners is unconstitutional; as this board, as organized, is not a court under the Constitution, and cannot, therefore, be invested with any of the judicial powers conferred upon the General Government.

"But the answer to the objection is that *the suit in the district court is to be regarded as an original proceeding*, the removal of the transcript, papers and evidence into it from the board of commissioners being but a mode of providing for the institution of the suit in that court. The transfer, it is true, is called an appeal. We must not, however, be misled by the name, but look to the substance and intent of the proceeding. *The district court is not confined to a mere re-examination of the case as heard and decided by the board of commissioners*, but hears the case *de novo* upon the papers and testimony which had been used before the board, they being made evidence in the district court; and also upon such further evidence as either party may see fit to produce."

In the case at bar the Statutes conferring the right of appeal provide that (*italics ours*)—

"the court, on petition, shall hear and determine such appeal and reverse the decision appealed from in a summary way *on the evidence produced before the Commissioner \* \* \** and the revision shall be confined to the *points set forth in the reasons of appeal*. (Section 4914 Revised Statutes.)

U. S. vs. FERREIRA, 13 How., 40.

(Cited and quoted above, also.)

In this case the Supreme Court of the United States declined to entertain an appeal from the Circuit Court for the District of Florida, in its determination of certain claims of individuals against the United States under a treaty with Spain. The Supreme Court held that the Circuit Court had

acted as a commissioner, and no appeal to the courts lay from its award. The question of the legality of the action of the Circuit Court was not before the Supreme Court, and they decline to pass upon it, but hint that it might be questioned.

GORDON VS. UNITED STATES, 2 WAL., 561; 117 U. S., 697.  
(Cited above.)

This was an appeal from a decision by the Court of Claims unfavorable to the appellant. The court held that the Constitution gave no appellate jurisdiction to the Supreme Court of the United States from the Court of Claims.

The courts have been equally prompt to decline to be made adjuncts or auxiliary instruments to the other departments, or to commissions and bureaus of those departments. They have insisted that their functions are limited not only to what may be abstractly judicial, but to the concrete and practical duties which the experience of governments has determined to be the proper province of a court of justice. They have repeatedly decided that they are confined to questions judicial in their nature, but that that fact alone is not enough to give them jurisdiction. The question must be presented in the form of a case or controversy, and must be one which pertains to the administration of justice by a court rather than incident to legislative or executive duties. They have steadily refused not only to revise the decision of other branches of the Government or intrude upon their proper domain of action, or to stop by injunction or compel by mandamus the action of other departments, but they have also refused their assistance by process, when called upon merely to aid another department or arm thereof to carry out some object properly within the functions of that

department. Upon this point we cite the cases of *re Interstate Commerce Commission*, *re McLean*, *re Pacific Railway Commission*, *Taylor vs. Commonwealth*.

RE INTERSTATE COMMERCE COMMISSION, CIRCUIT COURT N.  
D. ILL., 1892; 53 FED. REP., 476.

Application by the Interstate Commerce Commission for orders to compel certain persons to produce papers and testify before the Commission.

Gresham, J.:

"The Interstate Commerce Commission is an administrative and not a judicial body, and the important question presented for determination is, can the process of this Court be exercised in aid of an investigation before such tribunal. The jurisdiction of the United States Courts is limited, and it is not competent for Congress to confer upon them authority which is not strictly judicial, and *clearly within* the grant found in the 3rd Article of the Constitution.

\* \* \* The application of an administrative body to a judicial tribunal for the exercise of its functions in aid of the execution of nonjudicial duties does not make a 'case' or 'controversy' upon which the judicial power can be brought to bear. It is not a contention between litigants brought before a court by regular proceedings for the protection or enforcement of rights, or the prevention, redress or punishment of wrongs. The Commission was engaged in investigating charges of unlawful discrimination against certain railway companies and this Court is simply asked to aid that body in obtaining evidence, which, it is claimed, will tend to support the charge. The subject of the inquiry is not brought here for adjudication and this Court can exercise no discretion beyond deciding whether the evidence demanded is pertinent to the charge and within the general scope of Sec. 12 of the Act.

**"Congress cannot make the judicial department the mere adjunct or instrument of either of the other departments of Government."**

## IN RE PACIFIC RAILWAY COMMISSION, 32 FED. REP., 242.

Act constituting this commission provided that the Circuit or District Court of the United States, in case of refusal to testify before the commission, may issue an order, requiring such person to appear and testify. This is a request from such commission to the circuit court for such an order directed against Senator Stanford.

Held, per Field, J.:

"The Pacific Railway Commission is not a judicial body ; it possesses no judicial powers ; it can determine no rights of the Government or of the companies whose affairs it investigates. Those rights will remain the subject of judicial inquiry and determination as fully as though the commission had never been created, and in such inquiry its report to the President of its action will not be even admissible as evidence of any of the matters investigated." \* \* \*

"The provisions of the act authorizing the courts to aid in the investigation in the manner indicated must be adjudged void. **The Federal Courts under the Constitution cannot be made aids to any investigation by a commission or committee into affairs of any one.**"

In the matter of the application of the Senate, 10 Minn., 78. The following resolution was adopted by the Senate of Minnesota :

"*Resolved*, That the Supreme Court be, and hereby are, respectfully requested to furnish to the Senate their opinion upon the following questions : " \* \* \*

Whereupon the Court returned the following answer :

"The resolution, we presume, was passed in view of Sec. 15, Ch. 4, Comp. Stat., which provides that either House may by resolution request the opinion of the Supreme Court or any one or more of the judges thereof. The Constitution not only prevents an assumption by either department of power not properly belonging to it, but also prohibits the imposi-

tion by one of any duty upon either of the others not within the scope of its jurisdiction ; and ' it is the duty of each to abstain from and to oppose the encroachments on either.' Any departure from these important principles must be attended with evil." \* \* \*

IN RE McLEAN, 37 FED. REP., 648.

The Commissioner of Pensions requested the United States Court for the Eastern District of New York to issue a subpoena to one Callahan to appear at a certain place and time for examination by a special examiner of the Pension Bureau.

Benedict, J.:

"The request shows that the subpoena was desired for the purpose of enabling the Bureau of Pensions to make an examination into the facts bearing on a certain claim for a pension. \* \* \* For such purpose the aid of this court cannot, in my opinion, be invoked. The proceeding in aid of which the process of this court is asked is an executive examination pending in an executive department of the Government, not a judicial inquiry pending before a court. In cases of controversy pending before the courts of the United States those courts have power to compel the attendance of persons as witnesses, but, in my opinion, Congress is not authorized to permit that power to be invoked in aid of an executive examination pending in an executive department. Request denied."

TAYLOR VS. COMMONWEALTH, 3 J. J. MARSHALL (Ky.), 401.

A county court issued an order to effect that its clerkship was vacant, and appointing a new clerk. Plaintiff, the ousted clerk, brought a writ of error.

Held :

"The appointment of a clerk is not strictly speaking a judicial act, but is intrinsically executive. And although

the Constitution has confided to courts the appointment of their own clerks, still the nature of the power is not changed. It is essentially executive whensoever and by whomsoever it is exercised. It is as much executive when exercised by a court as by the Government. It is the prerogative of appointing to office, and is of the same nature, whether it belong to a court or to a governor. The appellate jurisdiction of this court is judicial. We can revise only what is judicial. Neither writ of error nor appeal would lie to this court to reverse or nullify any executive appointment or other executive act. If the governor make an illegal appointment, or if any other depository of any portion of the executive functions of government act irregularly or illegally in the exercise of the appointing power, the appointment cannot be set aside by the direct appeal to this court; nor can an incumbent who may have been illegally or unjustly supplanted by the unauthorized appointment of a successor rectify the error and procure his reinstatement by writ of error or appeal to this court to reverse the order appointing the successor or superseding himself. \* \* \*

"And we are of opinion that we cannot take cognizance of this writ of error because its direct object is to nullify an executive act, and not to reverse a judicial decision of the county court, it is not only unnecessary but improper to express any opinion on the various points presented in the range of the arguments of counsel."

In addition to those we have already cited we have a large class of cases on the general point of the independence of the departments so far as controlling the judgment and discretionary action of those departments is concerned.

These are cases, both State and National, in which the extraordinary remedies of mandamus and injunction have been asked against the executive department and refused by the courts. The effect of these cases is to hold that this

independence is always to be respected, and that a court will not interfere with an executive officer's exercise of discretion, nor will they inquire into the wisdom or justice of his decision or course of action.

This principle of constitutional law is fundamental and so well established as to need no argument. It lies at the foundation of our system of government. If it can be set aside whenever convenience suggests that it be done, that is an end of it as a principle of law.

We find as matter of actual experience that the courts have steadily refused to examine the justice of the individual case, or the degree of political danger that would be incurred by the violation of this principle of Government.

Such was the case in *U. S. vs. Ferreira*. The lower court had entertained jurisdiction, but the Supreme Court refused to hear an appeal from their decision. They expressed no opinion regarding the legality of the action of the inferior court, as that matter was not before them, and simply held that the action of the lower court was not judicial.

The early pension cases (*Hayburn's case* and *U. S. vs. Yale Todd*) are conspicuous examples of the adherence of the courts to the principle of independence and inaction. While realizing the benevolent motives which prompted Congress to enact the statute and the worthiness of the claimant's case, they still refused to violate this principle of our public law, and took great pains to state that, owing to the benevolent character of the proceeding, they would endeavor to find in the peculiar wording of the Act authority to act individually as commissioners.

There was no greater occasion to apprehend public danger from the court taking cognizance of that case than there is in the case at bar. The considerations of humanity were far more appealing than in the present case. Owing to the

paucity of executive officers, and the incomplete organization of the Government at that time, the plea of convenience was doubly powerful. There is certainly less cogent reason for the mingling of the powers of government in this instance than there was in that case. But the court refused to violate this fundamental principle. This fidelity of the courts to the law has marked their decisions all through our history.

In *Miss. vs. Johnson*, *Georgia vs. Stanton*, *Cherokee Nation vs. State of Georgia*, *Commr. of Patents vs. Whitely* and *U. S. ex rel. vs. Black*, the courts have refrained from interfering with the executive departments.

In the cases of *in re Pacific Railway Commission*, *in re Interstate Commerce Commission*, in the matter of the application of *McLean*, and in the opinion of the Supreme Court of *Minnesota*, in the *Matter of the Application of the Senate*, and other cases, *supra*, the courts have maintained their independence and dignity by declining to be made aids to the other departments.

They have recognized that "power is an aggressive thing," as Madison said, and must be confined and curtailed according to fixed principles or it will assume proportions dangerous to our system of government. This disregard of constitutional limitation in times of security, for harmless or even worthy purposes, will constitute a precedent for the consolidation of arbitrary power in an hour of danger, when great exigencies may furnish a seeming justification.

U. S. EX REL. DUNLAP VS. BLACK, 128 U. S., 40.

Application for a mandamus directing the Commissioner of Pensions to increase the pension of the relator under a certain construction of a statute. The Supreme Court of the District of Columbia refused the writ and the relator appealed to the United States Supreme Court.

It was held on the authority of *Marbury vs. Madison*, and later cases, that the writ would not lie :

"Whether if the law were properly before us for consideration, we should be of the same opinion or of a different opinion is a matter of no consequence. We have no appellate power over the Commissioner and no right to review his decision."

DECATUR VS. PAULDING, 12 PET., 513.

Paulding, as Secretary of the Navy, decided upon an application of Mrs. Decatur for a pension, that she must choose whether to take under a general pension act or one passed for her special benefit, and that she could not take under both, as she claimed the right to do. She brings a petition for mandamus.

Taney, Ch. J. :

"The court could not entertain an appeal from the decision of one of the Secretaries, nor revise his judgment in any case where the law had authorized him to exercise judgment or discretion. Nor can it by mandamus act directly upon the officer and guide and control his judgment and discretion in the matters committed to his care." Mandamus denied.

STATE OF GEORGIA VS. STANTON, 6 WALL., 50.

This was a bill for a restraining order against Stanton, Secretary of War *et al.*, to prevent these officers carrying into effect the Reconstruction Acts. The bill was filed in the United States Supreme Court, and the defendants made a motion for its dismissal for want of jurisdiction. It was urged that the subject-matter of the bill was of a political and not judicial nature.

Nelson, J., delivered the opinion of the court :

"This distinction (concerning the nature of the subject-matter of the suit) results from the organization of the Government into three great departments—executive, legislative, and judicial—and from the assignment and limitation of the powers of each by the Constitution. The judicial power is vested in the Supreme Court and such inferior courts as Congress may ordain and establish; the political power of the Government in the other two departments.

"The distinction between judicial and political power is so generally acknowledged in the jurisprudence of both England and this country that we need do no more than refer to some of the authorities on the subject. They are all in one direction. \* \* \*

The justice then considers the question of the character of the subject-matter, and concludes that it is political rather than judicial and hence the Court has no jurisdiction.

STATE EX REL. VS. STONE, 25 S. W. REP., 376, (Mo.)

Mandamus to compel the Governor of the State to carry out a contract. Held, it would not lie because the executive was independent of and not controllable by the courts.

Sherwood, J. :

"In this instance, we, constituting a portion of the judicial department of the government, are called upon to exercise, or what amounts to the same thing, to control the exercise of the powers belonging exclusively to the Executive Department of that government. To such action on our part the law interposes an insuperable barrier.

"The Constitution provides that, the powers of government shall be divided into three distinct departments—the legislative, executive, and judicial—each of which shall be confined to a separate magistracy, and no person, or collection of persons, charged with the exercise of powers properly belonging to any one of these departments shall exercise

any powers properly belonging to either of the others, except in the instances in this constitution expressly directed or permitted."

U. S. vs. GUTHRIE, 17 HOWARD, 284.

Petition for a mandamus to compel the Secretary of the Treasury to pay the relator a portion of his salary claimed as judge of the territory of Minnesota.

Daniel, J. :

"The only legitimate question for our determination upon the case before us is this: Whether, under the organization of the Federal Government, or by any known principle of law, there can be asserted a power in the Circuit Court of the United States for the District of Columbia, or in this court, to command the withdrawal of a sum or sums of money from the Treasury of the United States to be applied in satisfaction of disputed or controverted claims against the United States? \* \* \* The Government under such a *regime*, or rather under such an absence of all rule, would, if practicable at all, be administered not by the great departments ordained by the Constitution and laws, or guided by the modes therein prescribed, but by the uncertain and perhaps contradictory action of the courts in the enforcement of their views." Mandamus refused.

GAINS vs. THOMPSON, 7 WALL, 347.

This is a motion for an injunction to restrain the Secretary of the Interior from cancelling an entry in the Land Office whereby the plaintiff would be deprived of his title to land.

The Court held, per Miller, J. :

"That no such action could be maintained as it was controlling the Secretary in a *discretionary* duty, and not merely in a *ministerial* function." The cases of *Decatur vs. Paulding* and *Marbury vs. Madison*, etc., were regarded as controlling.

## BRASHEAR VS. MASON, 6 HOW., 99.

Application for a mandamus by Brashear against John G. Mason, Secretary of the Navy, to compel him to pay the relator his salary as an officer of the United States Navy. There was a dispute as to the legality of his claim, which depended on the construction of the treaty of annexation of Texas. This court held the claim unlawful, and then proceeded to say that, though it had been lawful, yet a mandamus would not have lain to enforce payment, holding the case of *Decatur vs. Paulding* decisive of this one.

## CHEROKEE NATION VS. STATE OF GEORGIA, 5 PETERS, 183, 184, 190.

A bill was filed to restrain the State of Georgia from enforcing its laws in the territory of the Cherokee tribe of Indians. Marshall, Ch. J., held that the court had no jurisdiction, because the Cherokee Nation was not a foreign state, and then proceeded :

"The bill requires us to control the legislature of Georgia, and to restrain the exertion of its physical force. The propriety of such an interposition by the court may be well questioned. It savors too much of the exercise of political power to be within the proper province of the judicial department. But the opinion on the point respecting parties makes it unnecessary to decide this question."

## COM'R OF PATENTS AGAINST WHITELY, 4 WALL., 522.

Whitely, the assignee of a sectional interest in a patent, applied to the Commissioner of Patents for a reissue. The Commissioner decided that the applicant was not entitled to the reissue asked for. Whitely petitioned the Supreme Court of the District of Columbia for a mandamus, directing the Commissioner to send the application to an examiner to be acted upon as though made by the patentee. The

Supreme Court of the District of Columbia issued the writ and the Commissioner appealed to the Supreme Court of the United States.

Swayne, J. :

"The principles of law relating to the remedy by *mandamus* are well settled.

"It lies where there is a refusal to perform a ministerial act involving no exercise of judgment or discretion.

"It lies, also, where the exercise of judgment and discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.

"It is applicable only in these two classes of cases. It cannot be made to perform the functions of a writ of error.

\* \* \* \* \*

"This case, as presented to the court below, was within neither of the categories above mentioned. The court, therefore, erred in making the order to which the Commissioner objected."

### **The Appeal is to a Court.**

The statute in question vests the appellate power over an executive officer in the COURT OF APPEALS. There is no intention to constitute the *judges* of that Court a commission for the discharge of executive duties. The language purports to confer appellate power upon that Court as a court, and indicates no intention to confer other power. In fact, the authority vested in them is peculiarly described to be that which was previously vested in the Supreme Court of the District of Columbia, *sitting in banc*.

That act purported to confer nothing but appellate judicial power upon the Supreme Court, and that is the character of power transferred to the Court of Appeals. The language of that act is only applicable to a court sitting as

a judicial tribunal. It purports to convey authority for purely judicial action.

Gordon *vs.* U. S. and Ferreira *vs.* U. S. *supra*, are considered authorities that such an act is unconstitutional.

But even if the act did not purport to convey such judicial authority, but purported to convey power upon the court to act in an executive capacity, that construction would invalidate the act for attempting to place upon the courts duties other than judicial. Such an attempt has been decided over and over to be unconstitutional. On this point we cite the cases of U. S. *vs.* Gale Todd, 13 How. 52, note, and U. S. *vs.* Ferreira, 13 How., 52, which are conclusive.

The question we submit is pivotal, and is this; is the Act of Congress which *in form* confers upon the Court of Appeals of the District of Columbia authority to finally and conclusively review, modify, reverse, or annul the action of an officer of the Executive Department of the Government, to wit, the Commissioner of Patents, acting in the discharge of his official duty, confessedly within the realm and scope of his jurisdiction, such officer not being a judge, and his office forming no part of the judicial system of the United States, but a part of the Executive or Administrative Department of the Government, constitutional?

First, that there is no question that Congress is authorized to select such means or agency as may be deemed fit and appropriate for carrying out, and into effect, the powers delegated to the Government by the people in the written Constitution, always provided the means and agency so selected are not in contravention of the letter or spirit of the Constitution itself.

Confessedly, this is a government of *delegated* powers, and no department of the Government may exercise any authority or power not expressly delegated or *necessarily* implied

from such delegated powers in order to carry out and into effect the powers expressly conferred.

It is obvious that the legislative power which finds expression in the act complained of was not expressly conferred by the Constitution, nor is it a necessary implication to give full effect to the clause which confers upon Congress the power "to promote science and the useful arts," since obviously no such necessity exists; so it is that in the exercise of this jurisdiction the Court invades the domain of another department of the Government and dominates it to the extent that it changes, modifies, or annuls the action of that Department.

It may be urged that the proceedings in relation to the granting of a patent are essentially judicial in their character.

That is undoubtedly true, but the Supreme Court of the United States and the courts of the States have decided over and over again that the fact that the functions of an office are judicial in their character does not determine the character or quality of the tribunal. In other words, it does not follow, because some of the officers of the Government, either in the Legislative or Executive Departments, must, in the discharge of their duties, hear evidence and determine upon that evidence what the law is and what their actions shall be, that they are thereby discharging the functions of a judicial office in the sense of the Constitution, or that such officer is a judge or his office a court.

The cases we have cited, we submit, from the Supreme Court and from the courts of the States, clearly sustain our contention, and, we, therefore, urge most respectfully that on reason and authority the jurisdiction we assail cannot be sustained.

And with due submission we may add that the disposition

and tendency of the several departments to cross departmental lines and to exercise power and authority not conferred by the Constitution has reached the limit consistent with public safety, and we are justified in the hope and belief that the disposition of the Court will be in the direction of conservatism.

The Court of Appeals laid much stress on the decision of this Court in *Butterworth vs. Hoe*, *supra*.

In that case, however, the question at bar was not raised nor discussed, and so far as that case may appear to point in the direction of maintaining this jurisdiction it is at war with every case where the question has been directly raised and decided. Moreover, other decisions of the Supreme Court and of the State courts, in marking the limitations of the legislative, judiciary and executive power, have all been against the soundness of the suggestion contained therein, viz: that the action of the Supreme Court of the District, in case of an appeal from the Commissioner of Patents, is "in aid of" the Patent Office.

The Court will observe that in *Butterworth vs. Hoe* it is expressly decided that the "appeal" was not, in the sense of the Constitution, a judicial one, either according to the forms and practice of the common law or proceedings in equity.

The only question that *was* raised or decided was whether, *in view of the acts of Congress then in force*, the Secretary of the Interior, as the head of the Department, had power to revise and reverse the decisions of the Commissioner disallowing an application for a patent; and your Honors held that he had not. This determination does not in any way preclude your Honors from, nor ought it to influence you against, deciding the question now before you; for the question of the constitutionality of the acts conferring the jurisdiction in appeal upon the courts was not there raised or considered.

Your Honors made the decision upon the supposition that all the statutes on the statute books were in full force and effect.

Moreover, so far as appeals in interference cases are concerned, the act of Congress (Feb. 9, 1893, which established said Court of Appeals) conferring the right of appeal in *them* was not yet passed; and, of course, was not considered in said decision.

On the other hand, as above stated, *Butterworth vs. Hoe* itself admits without question (what cannot be questioned, we submit) that the Commissioner of Patents is an executive officer, under the Secretary, and a part of a regular executive department of the Government. It was upon this ground, and upon the ground that an appeal lay to him from the Land Office, that the defendants in error maintained that an appeal lay to him from the *Commissioner of Patents*; but Mr. Justice Matthews says that, in determining that question, you must consider the acts of Congress which bear upon the respective powers of the Secretary and of this particular bureau—the Patent Office—and that, having considered them (p. 61):

“The inference is that an appeal is allowed from the decision of the Commissioner refusing a patent, not for the purpose of withdrawing that decision from the review of the Secretary, under his power to direct and superintend, but because, without that appeal, it was intended that the decision of the Commissioner should stand as the final judgment of the Patent Office, and of the Executive Department, of which it is a part.”

We cite this language especially because it shows that, even if your Honors now hold as we believe you should, *Butterworth vs. Hoe* would still stand as the law in regard to an appeal to the Secretary from the Commissioner of Patents; for you there hold that you deny the right of appeal to the Secretary because the provisions of law conferring power

over the issuance of patents upon the Commissioner make his judgment final so far as the *executive* is concerned and *not* because of the existence of the laws (those here in question) which give an appeal to the courts.

The *right* of Congress to confer jurisdiction in appeal upon a *court*, or upon the Court of Appeals in particular, was not considered or passed upon in *Butterworth vs. Hoe*.

Therefore, notwithstanding this decision, *if* the judicial and executive departments of our Government are independent and coequal, as we submit they are, your Honors ought not to allow this jurisdiction in appeal to stand ; for, so far as the allowance or disallowance of applications for *patents*, at least, is concerned, the acts of Congress in question make the judicial the *final resort over the executive*. The "decision \* \* \* shall govern the further proceedings in the case," says Sec. 4914, R. S. Thus, what is *in its nature executive* ; what, when Congress *first* exercised its power under Art. 1, Sec. 8-8 "to promote the Progress of Science and the useful Arts" was *placed in the executive* ; what was found there when Congress first gave an appeal to a court, and when (in 1893) Congress first gave an appeal in interference cases also ; and what is found there now (except as controlled by this appeal, which we submit is unconstitutional) is transferred, in its ultimate control, to the *judiciary* ; and the separate powers of our Government are no longer independent and coequal, but the one is enabled to tyrannize over, supersede and destroy the other.

If the boundary may be overstepped at all, where is the limit ? What we anticipate will be the main defence itself brings us to this conclusion. Supposing that the power conferred by Art. 1, Sec. 8-8 "to promote the Progress of Science and the useful Arts," etc., is a *special grant* of power to Congress, and that, therefore, Congress may use *any* means, *either executive or judicial, or both*, that it sees fit ; then

it follows as a matter of course that Congress may give a right of appeal to the Court of Appeals of the District of Columbia (and probably to any other court) from the final action of the officers of the Post Office, Navy or War Departments, etc., for the power "To establish Post Offices and Post roads" (Art. 1, Sec. 8-7), "To raise and support Armies," etc. (Sec. 8-12), and "To provide and maintain a Navy" (Sec. 8-13), are *equally special grants of power to Congress*.

### ANOTHER POINT OF VIEW.

Let us now look at the laws in question from a point of view not heretofore taken.

We submit that the Courts of the District of Columbia have always been considered, and are in fact, *United States Courts*, and that the Court of Appeals of the District of Columbia was established by Congress under the authority of Art. 3, Sec. 1, and Art. 1, Secs. 8-9, of the Constitution as one of the so-called "inferior courts," and *not* under Art. 1, Secs. 8-17, which gives Congress exclusive jurisdiction over the District of Columbia. This is so, we submit, because (speaking generally; and, as to patent appeals, specifically,) the Court of Appeals exercises the jurisdiction of the old General Term of the Supreme Court of the District of Columbia, which Court was formerly known as the *United States Circuit Court for the District of Columbia*. And the Supreme Court of the United States has already determined that the Supreme Court of the District of Columbia is a court of the United States (*Cochrane vs. Deener*, 94 U. S., 780; *Embry vs. Palmer*, 107 U. S., 3). Moreover, the Attorney-General of the *United States* provides the accommodations for the Court of Appeals (Sec. 12, Act of Feb. 9, 1893); its process is issued in the name of the President; its pro-

cess is served by "the marshal of the *United States* for the District of Columbia" (Sec. 13); and it has been judicially determined (*Noerr vs. Brewer*, 1 Mc. Ar., 507) that Section 858 of the R. S. U. S., which relates to evidence and which begins "*In the Courts of the United States*," applies to the Courts of the District of Columbia.

But, even admitting that the Court of Appeals of the District of Columbia was established *partly* under the sections authorizing the establishment of "inferior courts" and *partly* under the section conferring exclusive jurisdiction over the District of Columbia, it is very evident that *that part of its jurisdiction which relates to appeals from the Commissioner of Patents could not have been conferred under the authority of the last section*; for the *subject-matter* is not connected with the District within the meaning of that section, nor are the *parties* generally, and certainly not necessarily, *residents of the District*.

As an United States court, therefore, the jurisdiction of the Court of Appeals of the District of Columbia is limited by the Constitution (Art. III, Sec. 2)-to "*cases in law and equity, arising under \* \* \* the laws of the United States.*"

Is, then, an appeal, under the acts in question, a "case"?

There can be no doubt that Congress can confer upon the courts of the District of Columbia (as they have done—act of February 9, 1893, Sec. 8), as well as upon *other* Federal courts, jurisdiction over cases arising under the patent laws: that is, involving *patents*. But this "appeal" to the Court of Appeals takes place *before the patent has issued* and involves *not a patent but merely the refusal by the Commissioner to allow an application* or one of two or more applications therefor.

In other words, these appeals, since the law of 1893, are permitted in two instances: where there is but one application for a patent and this is denied by the Commissioner;

and where there are two or more applicants (interference cases) and the appeal is taken by that applicant (or by one of two or more) whose application has been refused by the Commissioner.

In *either*, the Commissioner of Patents has not only exercised his discretion (or, in other words, acted quasi-judicially) as an executive officer, but has exercised his discretion *adversely to the party* who takes the appeal. If the appeal, under these circumstances, is a "case," it is one of a very peculiar nature; for we do not recall any time in the history of the English law, since "the white doe slacked her thirst in the blue waters of the Thames," when an executive officer could be reached in his actions by a court except by *mandamus* and to compel a *ministerial* act only, and that has been the uniform ruling of the Supreme Court of the United States.

But aside from the questions whether a *mandamus* is the only proceeding yet recognized in the courts to reach the acts of an executive officer and whether your Honors desire now to recognize an *appeal* also, let us consider whether this so-called "appeal" is a "case" in other respects.

In *Piqua Bank vs. Knoup*, 6 O. St., 357, Bartley, C. J., says (*italics his*):

"A *case* in law or equity is a suit or proceeding in court, invoking the exercise of judicial power, and consisting as well of the parties as of their rights. There is a manifest distinction between a *question in law or equity*, and a *case in law or equity*. Although every *case* in law or equity involves a *question*, yet many questions may arise seriously affecting the rights of persons, which do not constitute a case in law or equity. It appears that Chief Justice Marshall, when a member of Congress, in a debate in relation to the famous case of Jonathan Robbins, gave an exposition of the term

'a case in law,' as used in the Constitution, in the following words:

"By the Constitution, the judicial power of the United States is extended to *all cases* in law and equity arising under the Constitution, laws and treaties of the United States; but the resolutions declare the judicial power to extend to *all questions* arising under the Constitution, laws and treaties of the United States. The difference between the Constitution and the resolutions was material and apparent. *A case in law or equity was a term well understood, and of limited signification.* It was a controversy between parties that had taken a shape for judicial decision. If the judicial power extended to every *question* under the Constitution, it would involve almost every subject proper for legislative discussion and decision; if to every *question* under the laws and treaties of the United States, it would involve almost every subject upon which the executive could act. The division of power, which the gentleman had said could exist no longer, and the *other departments* would be *swallowed up by the judiciary.* By extending the judicial power to all cases in law and equity, the Constitution had never been understood to confer upon that department any political power whatever. To come within this description, a *question* must assume a legal form for forensic litigation and judicial decision. *There must be parties to come into court who can be reached by its process, and bound by its power; whose rights admit of ultimate decision by a tribunal to which they are bound to submit.* 5 Wheat. Rep., Appendix."

"This interpretation is unquestionable."

Turning to the Annals of Congress (6th Cong., 1799-1801, 605), we find that this quotation is correct and we find also that, just preceding the quotation, is the following:

"This, Mr. M. said, led to his second proposition, which was:

"That the case was a case for Executive and not Judicial decision. **He admitted implicitly the division of powers,** stated by the gentleman from New York, and that

**it was the duty of each department to resist the encroachments of the others."**

It is very evident, therefore, that, in order to be a "case," the so-called "appeal" must be *an appeal in a "case"*—in which event there must have been a "case" in the Patent Office, or it must be (though called an "appeal" by Congress) a "*case originally instituted in the Court of Appeals.*"

We must inquire then :

1. Is it an *appeal* in a "case" ?

It would seem to be so, if a "case" at all ; for the acts expressly call it an "appeal," and, moreover, the Court passes upon only "the evidence produced before the Commissioner" (Sec. 4914, R. S.), except that "at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded" (Sec. 4913, R. S.).

But unless your Honors care to deny what seems to be self-evident and what has already been recognized in *Butterworth vs. Hoe*, and care to hold that the Commissioner is a part of the *judiciary* and not of the executive, then there cannot have been a "case" *in the Patent Office* ; for in the language of Bartley, C. J., *supra*, "a case in law or equity is a suit or proceeding *in a court.*"

Aside from this, however, the inquiry will be treated under two heads (A and B) :

A. Cases in which there is but a *single applicant* for a patent and the Commissioner refuses such application. This, of course, is not the case at bar.

Does the filing of an application for a patent, or even its prosecution in the Patent Office, make it a "case" within the meaning of the Constitution ? We think not. It is merely

an *ex-parte* application to the Commissioner, asking that a patent be issued to the applicant, if, in the exercise of his discretion as an executive officer, he shall think the applicant entitled thereto under the law. A "case" is a question *contested* before a court of justice (*Ex-parte* Towles, 48 Tex., 413, 433); and "A case in law and equity consists of the right of the *one* party as well as of the *other*, and may truly be said to arise, etc.," says Chief Justice Marshall in *Cohens vs. Virginia*, 6 Wheat., 264, 379.

But here there is clearly *no contestant*—no opposing party—unless it be the Commissioner of Patents. In one sense, of course, the *United States* is an interested party, but it is not a nominal party and could not be sued anyway. And, as to the Commissioner, we find that he has already been judicially determined not to be an opposing party, as we know that he could not be. These cases arose, it is true, under Sec. 4915, R. S., giving relief by bill in equity; but, upon the point in question, they are in every sense precedents.

In *The Mergenthaler Linotype Co. vs. Seymour*, Commissioner of Patents, The Rogers Typographic Company, and Jacob W. Shuckers (January 20, 1894), 66 O. G., 1311, upon a *demurrer to the bill for misjoinder of parties*, Mr. Justice Hagner, of the Supreme Court of the District of Columbia, said:

"Notwithstanding the careful argument of complainant's counsel, I think the Commissioner of Patents was *neither* a *necessary party* *nor* a *proper party* to this bill.

"The complainant insists that the Commissioner should, or at least may, be sued in this case for the reason that he is an adverse party to the present application.

"But I think *the Commissioner can no more*, in any just sense, *be considered as occupying such a relation* to the application, within the meaning of the law, *than the Supreme Court of the District of Columbia* could be so considered. True, the Commissioner has affirmed a decision of his official subordinates which was unfavorable to the pretensions

of the complainant ; but his decision was a judicial act [an exercise of discretion, or what is decided in *Butterworth vs. Hoe* to be *quasi-judicial*] just as the ruling of the Supreme Court of the District of Columbia would be when it should affirm or reverse the Commissioner's ruling. It would be a strange proceeding to summon the Court to appear and answer a bill like the present upon the pretense that it was an adverse party."

In *Graham vs. Teter*, 25 F. R, 555, upon objections for want of parties, Mr. Justice Bradley, said :

"It is further ordered that the objection that the Commissioner of Patents is not made a party be overruled."

B. Cases in which there are two or more applicants for a similar patent, or for one or more similar claims, and in which an interference has been declared and a decision rendered by the Commissioner in favor of *one* of them. This is the case at bar.

These applications are filed separately. No claim at any time is made *by one applicant against the other* ; and, especially, since neither has anything that he can give. *The interference is declared by a subordinate under the Commissioner* (Sec. 4904, R. S.) ; and it may afterwards be dissolved by a subordinate, if, in his opinion, the two or more applications, or claims, do not cover the same subject-matter. The interference is not a "case," we submit, within the meaning of Art. III, Sec. 2, but is *declared* and is *put in the form of a case* only for the *convenience* of the Patent Office.

But, supposing that your Honors, despite these arguments and despite the fact that the Commissioner is not a court, should decide that an interference *in the Patent Office* is a "case," even then there is another and entirely distinct objection that arises to the constitutionality of the law of February 9, 1893.

The Fifth Amendment to the Constitution says : "No

person shall \* \* \* be deprived of \* \* \* property without due process of law."

If there is a "case" in the *Patent Office*, each of the parties to it ought to be *cited on the appeal*, and by the officers of the Court of Appeals; and there ought to be some return showing service. "A *citation*, with *due return*, or waiver by general appearance or otherwise, is *indispensable to jurisdiction on appeal*" (*Alviso vs. U. S.*, 5 Wall., 824); also, *Mead, Ex. vs. Platt, Assignee*, 17 F. R., 509; *Stuart vs. Palmer*, 74 N. Y., 191, and *Witherbee vs. Supervisors*, 74 N. Y., 234.

Under the law as it now stands, however, the *only notice of appeal* which the appellant is required to give is to the *Commissioner* (Sec. 4912, R. S. U. S.); and by *implication* only does the requirement to give *him* notice relate to *interference* cases, because, when this section was enacted, the courts did not have jurisdiction in appeal in such cases.

The only regard paid to the rights of the opposing party or parties to the interference upon the appeal is embodied in Sec. 4913, R. S., viz :

"The court shall, before *hearing* such appeal, give notice to the *Commissioner* of the time and place of the hearing, and on receiving such notice the *Commissioner* shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein";

and in Rule XX-4 of the Rules of the Court of Appeals, viz :

"\* \* \* it shall be the duty of the Clerk of this Court to give special notice to the said *Commissioner* at least *fifteen days* immediately preceding the times thus respectively *fixed for the hearing* of said cases; \* \* \* and thereupon the *Commissioner* shall give notice to the parties interested or concerned by notice addressed to them severally by *mail*."

It will thus be seen that the opposing parties to the interference have *no notice whatever of the appeal*; and the notice

of the *hearing even* is given by the Clerk to the Commissioner only fifteen days before the hearing, and he is to *mail* the notice to the parties interested. If the parties interested happen to live in California, how much time is thus given them, after receiving notice of the hearing, to engage an attorney, perhaps to send that attorney by rail to Washington, or to engage by mail an attorney in Washington and for that attorney to prepare his argument?

And this is the law as laid down by Congress despite the fact that the appeal is always taken by the applicants, or one of them, who has been *defeated* in the interference proceeding. Whether there is or is not a "case" at all, or whether the so-called "appeal" is an *appeal* from a "case" or a "case" *originally instituted in the Court of Appeals*, the party who was *successful* before the Commissioner in the interference proceeding should be *cited* on the appeal, and not simply given a notice indirectly by mail (or perhaps not given it at all, and certainly not a reasonable time before) of the hearing.

This is so, because a patent has often been decided to be property; and, though, when the appeal is taken, no patent has yet been issued to that patent-applicant whom we claim should be cited on the appeal, invariably and necessarily at that time *his* application for a patent has been *allowed* by the Commissioner and his right thereto settled to such an extent that he has become *vested with property* the deliverance of the evidence of which he can enforce by mandamus (*Butterworth vs. Hoe*). And that Bernardin did have a hearing in the Court of Appeals cannot affect our position, we submit, if the *acts* in question do not, *of themselves*, protect the rights of the *successful* party to the interference in the appeal.

2. Is the so-called "appeal" a "case" originally instituted in the Court of Appeals of the District of Columbia?

The language of the act itself in calling it an "appeal" would seem to answer this question in the negative; and, we submit, that the fact that the parties are limited to the record in the Patent Office *absolutely establishes it*. But, let us inquire further, and under two heads (A and B):

A. Cases in which there is but a single applicant.

We have seen that the Commissioner cannot be considered a proper party, nor is he made so on the record. Yet, of this appeal he only is given notice and it is his attorney who appears to oppose the appellant. He, as seen (Sec. 4913, R. S.), may even be called upon to testify before the court as to the "principles of the thing for which a patent is demanded." What a peculiar situation! Certainly this is not a case within the meaning of the Constitution. In support of our view, we cite *ex-parte* Towles *et al.*, 48 Tex., 413, the syllabus of which reads as follows:

"An *ex parte* proceeding in the district court, by a voter who invokes its jurisdiction, to review the proceedings of a Commissioner's Court in passing upon a contested election for the selection of a county seat of his county, is wanting in all the attributes of a case or suit cognizable in the district court. Such a proceeding has neither subject-matter or *parties* conformable to its jurisdiction."

B. Interference cases.

That these are not "cases" originally instituted is shown by the arguments already made; and, above all, because no *citation*, or *other process*, is issued or served upon the opposing party to and the successful party in the interference in the Patent Office, or to *anybody else*—except the notice of the appeal to the Commissioner. They are not "cases" *de novo*, because the *parties* are bound by the record of the interference in the Patent Office. And they are not "cases" because the parties to the interference may be and usually

are, citizens of the States; and, therefore, the "appeal" does not come within the language, already quoted, of Marshall: "There must be *parties* to come into court who can be *reached by its process* \* \* \*"

Nor, as already submitted, is the Court *acting as a court* within the language of Marshall, *supra*:

"There must be parties to come into court who can be reached by its process and *bound by its power*; whose rights admit of *ultimate decision* by a tribunal to which they are bound to submit."

Along this line, let us call your Honors' attention to what you are doubtless already aware of, viz; that, in the Circuit Courts and Circuit Courts of Appeals of the United States, in infringement cases, though the patent in suit be issued by the Commissioner after an appeal to and a reversal of his decision by the Court of Appeals of the District of Columbia, the questions passed upon by the Commissioner and said Court on appeal are considered *de novo* and *the decision of the Court of Appeals of the District of Columbia considered to be in no way binding upon them*. And this would be so, though the same prior patents, and those only—against the priority of which the Court of Appeals of the District of Columbia may have decided—be cited in defence. Indeed, it is very evident that the *same persons* who have been parties to an interference, although it has been decided in favor of one on appeal by the Court of Appeals of the District of Columbia, may after patent issues, become parties—and the *sole parties*—to an infringement proceeding, and that the *testimony* which was used in the Patent Office previously and on the appeal, and upon which the Court of Appeals of the District of Columbia declared the one person entitled to a patent, may, by stipulation, become the *only testimony* in the infringement suit (except, perhaps, as to the fact of infringement and the

amount of damages or profits); and yet the decision of the Court of Appeals of the District of Columbia *upon that very testimony, taken by the same parties, will not be final*—will not be *res judicata*. In like manner, the United States Courts, under a bill in equity (Sec. 4915, R. S.), may, *between the same parties and upon the same record* that was passed upon by the Court of Appeals of the District of Columbia, decide the case as if the questions involved, or that record, had never been passed upon by a court.

That this is so appears from the law itself (Sec. 4914, R. S.):

“But no opinion or decision of the court in any such case shall preclude *any person* interested from the right to contest the validity of such patent in *any court* wherein the same may be called in question.”

The consequence of this is that it must be admitted that, in these so-called “appeals”—whether there be a single application for a patent or two or more (interference cases)—the Court of Appeals of the District of Columbia acts *not as a court* but merely as a *reviewing board* over the acts of an executive officer of the Government.

Mr. Justice Matthews, in *Butterworth vs. Hoe* (though speaking only of appeals where there was but *one* applicant for the patent), himself says (p. 60):

“It is evident that the appeal thus given to the Supreme Court of the District of Columbia [the Court of Appeals was established since this decision] from the decision of the Commissioner, is not the exercise of ordinary jurisdiction at law or in equity on the part of that court, but is one step in the statutory proceeding under the patent laws whereby that tribunal is interposed in aid of the Patent Office, though not subject to it. Its adjudication, though not binding upon any who choose by litigation in courts of general jurisdiction to question the validity of any patent thus awarded, is, nevertheless, conclusive upon the Patent Office itself, \* \* \*.”

The learned judge there recognizes that this so-called "appeal" "*is not the exercise of ordinary jurisdiction at law or in equity on the part of that court;*" and what does the language mean if not that the court is *not acting as a court*? It certainly implies that, and to that extent it should be considered by your Honors in arriving at your decision in the case at bar. That Mr. Justice Bradley so recognized, and that, at the same time, he recognized that the acts of Congress gave the judiciary the final "say" over the executive, and yet did not, on those accounts, go further and hold, as we maintain your Honors should *now* hold, that the acts conferring jurisdiction in appeal are unconstitutional, *is of no moment*; because your Honors were not called upon in that case to determine this question, nor did you consider it.

And *if*, in these appeals, the Court of Appeals of the District of Columbia *does not act as a court*, then the power conferred upon it is clearly unconstitutional under the decisions already rendered by your Honors. As expressed by Cooley, in his principles of the Constitution: "Upon judges as such no functions can be imposed except those of a *judicial nature*."

### CONCLUSION.

The conclusion based on the foregoing propositions and authorities is that—

(1) The Constitution of the United States does not permit mingling of the departmental powers of government, but provides for their separation.

This is manifest from the language of the instrument interpreted in the light of the State Constitutions of that

period, as well as from the manifest intention conveyed by the language of the Constitution itself.

(2) The courts have always maintained this distinction regardless of the merits of the case presented.

(3) An appeal from an executive officer to a court is such a mingling of these functions as to be unconstitutional.

(4) The Commissioner of Patents is an executive officer, and his decisions on executive matters are the determinations of an executive officer and not judicial decisions.

The appeal given by the Revised Statutes, sections 4911, 4912, 4913, 4914, and by the ninth section of the Act of Congress, approved February 9, 1893, creating the Court of Appeals of the District of Columbia, is in violation of the constitutional principle contended for, and those Acts which provide for such an appeal are consequently unconstitutional, null and void; and therefore said court is without jurisdiction to hear an appeal from the Commissioner of Patents.

It is admitted that the Commissioner of Patents would issue the patent to the applicant Bernardin, if not restrained and controlled by the finding and decision of the Court of Appeals.

As in the case of *Butterworth vs. Hoe*, Commissioner, so here the Commissioner admits that in his judgment Bernardin is entitled to receive a patent on his application, and that the only reason he refuses to issue the patent is, because the Court of Appeals on the appeal set aside the award and reversed the decision of the Commissioner.

If, as we protest, the Court of Appeals was and is without jurisdiction to review the action of the Commissioner of Patents, the proceeding is void, and the objection urged by

the Commissioner, and his reason for withholding the patent, which he admits Bernardin is entitled to have, and would have but for the action of said Court of Appeals, cannot avail, and we are entitled to the writ ordering the performance of that merely ministerial duty.

All of which is respectfully submitted.

JULIAN C. DOWELL,  
GEORGE C. HAZELTON,  
*Attorneys for Plaintiff in Error.*

N<sup>o</sup>. 444.

App<sup>y</sup> to Bp. for

Filed Nov. 21, 1898.

Office Supreme Court U. S.

FILED  
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JAMES H. MCKENNEY,  
Clerk.

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In the Supreme Court of the United States.

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In re United States Ex Rel. Alfred L. Bernardin vs.  
Charles H. Duell, Commissioner of Patents, Octo-  
ber Term, 1898, No. ~~461~~. 444.

In Error to the Court of Appeals of the District of  
Columbia.

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OPINION OF COURT OF APPEALS

IN

BERNARDIN vs. SEYMOUR,

10 App. Cas. D. C., 294.

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THE UNITED STATES, ex rel.  
ALFRED L. BERNARDIN,  
appellant, } No. 603.  
vs.  
JOHN S. SEYMOUR, Commis-  
sioner of Patents. }

1—This is an appeal from a judgment of the Supreme Court of the District of Columbia dismissing a petition for a writ of *mandamus* to the Commissioner of Patents.

The relator, Bernardin, and William H. Northall were parties to an interference proceeding in the Patent Office declared on their respective applications for a patent for an improvement in bottle sealing devices.

The Commissioner of Patents, being of the opinion that Bernardin was the first inventor, rendered a decision in his favor. On appeal to this court, by Northall, the decision of the Commissioner was reversed. Bernardin, denying the jurisdiction of this court to entertain an appeal from the decision of the Commissioner, demanded the patent to which he was entitled thereunder. This demand was refused because of the reversal of that decision by this court and the award of priority to Northall.

The sole question to be determined is, the jurisdiction of this court to entertain appeals from the Commissioner of Patents; for, without setting out the pleadings, it is sufficient to say that they make a case in which the *mandamus* ought to issue, if Congress had not the power to confer that jurisdiction, under the rule laid down in *Butterworth v. Hoe* 112 U. S. 50.

The argument against the constitutionality of the act of Congress is founded in the complete separation and independence of the powers of government declared in the Constitution.

In the language of Mr. Justice Miller: "It is believed to be one of the chief merits of the American system of written constitutional law, that all the powers intrusted to government, whether State or National, are divided into the three

grand departments, the executive, the legislative and the judicial. That the functions appropriate to each of these branches of government shall be vested in a separate body of public servants, and that the perfection of the system requires that the lines which separate and divide these departments shall be broadly and clearly defined. It is also essential to the successful working of this system that the persons intrusted with power in any one of these branches shall not be permitted to encroach upon the powers confided to the others, but that each shall, by the law of its creation, be limited to the exercise of the powers appropriate to its own department and no other". After noting several exceptions to the general rule expressly provided in the constitution, he says again: "In the main, however, that instrument, the model on which are constructed the fundamental laws of the States, has blocked out with singular precision, and in bold lines, in its three primary articles, the allotment of power to the executive, the legislative and the judicial departments of government. It also remains true, as a general rule, that the powers confided by the Constitution to one of these departments can not be exercised by another". *Kilbourn v. Thompson* 103 U. S. 168, 190.

The contention on behalf of the appellant is, therefore, that the Commissioner of Patents is an officer of the executive department, clothed with functions and charged with duties executive in their character; and that the exercise of his judgment and discretion therein is beyond the control of the judiciary and can not be conferred thereon by act of the legislative department with the approval of the President.

The question, as presented, is one of importance and its rightful determination is a matter of grave doubt. If resolved against the exercise of the jurisdiction there will doubtless be some embarrassing, if not injurious, consequences; for it has been constantly exercised by the courts of this District since the year 1839, and, of late years especially, many decisions of the courts, upon appeal from the Commissioner of Patents, have been carried into effect and accepted as conclusive and final. Notwithstanding the grave doubt that we entertain of the soundness of our judgment, we are not convinced that it is our duty to declare against the validity of the statute conferring the jurisdiction.

The very fact that we entertain doubt is, of itself, sufficient ground for our action in upholding the power of Congress to enact the law.

"It is our duty, when required in the regular course of judicial proceedings, to declare an act of Congress void if not within the legislative power of the United States; but this declaration should never be made except in a clear case. Every possible presumption is in favor of the validity of a statute, and this continues until the contrary is shown beyond a reasonable doubt. One branch of the government can not encroach on the domain of another without danger. The safety of our institutions depends in no small degree on a strict observance of this statutory rule." *Sinking Fund Cases* 99 U. S. 700, 718. See also *Powell v. Pennsylvania* 127 U. S. 678, 684.

The concluding sentences of the foregoing quotation show that the rule therein enounced is founded on the very same principle that lies at the base of the appellant's contention here.

The first act conferring jurisdiction on the court of this District, of appeals from the Commissioner of Patents was approved March 3, 1839 and the same has been exercised, with some changes in procedure only, continuously since that time. During nearly sixty years of existence the validity of the law remained unassailed and unquestioned. Moreover, the validity of this legislation was unmistakably assumed by the Supreme Court of the United States in the very case of *Butterworth v. Hoe supra*, wherein it was held that the express grant of an appeal from the decisions of the Commissioner to the Courts, precluded the exercise of the appellate jurisdiction claimed by the head of the department to which the Patent Office is attached, namely, the Secretary of the Interior.

In consideration of the importance of the question and the points made in the able argument upon which it has been submitted, we think it proper to offer some additional reasons in support of our conclusion.

The Constitution of the United States confers upon Congress the power, "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and

discoveries". Art. 1, Sec. VIII. Vested with this power it became the duty of Congress to carry it into execution by appropriate legislation. To that end it was vested with discretion to adopt any means or plan suitable for the purpose not inconsistent with the letter or spirit of the Constitution. *McCulloch v. Maryland* 4 Wheat 316; *Interstate Commerce Com. v. Brimson* 154 U. S. 447, 472, 473.

The first act of Congress (A. D. 1790) conferred the power to issue patents upon the Secretaries of State and War and the Attorney General, or any two of them. The act of 1793 authorized them to issue by the Secretary of State upon the certificate of the Attorney General that they conformed to the act; and the parties, in cases of interference, were authorized to select arbitrators for the determination of the controversy. By the act of 1836 the Patent Office was created, in the department of state, and given in charge of an officer called the Commissioner of Patents. Appeals from him were given to a board of examiners. And by section 16 of the same act a remedy by bill in equity was given, as now provided in R. S. sections 4915, 4918.

By the act of March 3, 1839 an appeal was given from the Commissioner to the Chief Justice or either of the Associate Judges of the Circuit Court of the District of Columbia. By the act of 1849 the Patent Office was transferred to the Department of the Interior. Amendments were, from time to time, made in the law, and several tribunals were provided in the office for examination and inquiry into the merits of claims for inventions, with appeal from one to another and then finally to the Commissioner. The appeal from the Commissioner in all cases of refusal of patent was continued in the Courts of the District of Columbia, with such changes as were necessary through the changes made in the judicial system thereof. Finally, by the act approved February 9, 1893, (27 Stat. at Large 434) creating the Court of Appeals of the District of Columbia, the determination of appeals from the Commissioner of Patents as formerly vested in the General Term of the Supreme Court of the District was vested therein and, in addition, it was provided that "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals".—(sec. 9.) It was under

this clause that the appeal was taken in *Northall v. Bernardin* that is now the subject of discussion.

Under the law, the functions of the Commissioner of Patents are both executive, or administrative, and judicial; the latter preponderating in importance. In matters administrative merely he is under the supervision of the Secretary of the Interior; but when acting judicially, so to speak, his decisions can only be reviewed by the court. *Butterworth v. Hoe* 112 U. S. 50, 66, 67. In that case Mr. Justice Matthews, after a review of the provisions of the patent law, said: "It thus appears, not only that the judgment and discretion of the Commissioner, as the head of the Patent Office, is substituted for that of the head of the department, but also, that that discretion and judgment are not arbitrary, but are governed by fixed rules of right, according to which the title of the claimant appears from an investigation for the conduct of which ample and elaborate provision is made; and that his discretion and judgment, exercised upon the material thus provided, are subject to review by judicial tribunals whose jurisdiction is defined by the same statute. \* \* \* \* \* It is not consistent with the idea of judicial action that it should be subject to the action of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to its subordinates. Such a subjection takes from it the quality of a judicial act. That it was intended that the Commissioner of Patents, in issuing, or withholding patents, in re-issues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed".

In the cases of issuing or withholding patents, re-issues, and extensions the judicial function is exercised in investigating the proofs and determining the right as between the claimant, on one hand, of what may be a valuable right of property, and the public, on the other, interested in defeating what may be an unlawful monopoly. In interference cases the proceeding is distinctly judicial. The controversy is waged between adverse claimants of the same right of property and the public has no interest therein. It contains

"all the elements of a civil case—a complainant, a defendant and a judge-actor, *reus et judex*". Fong Yue Ting v. U. S. 149, U. S. 698, 729.

In this view of the most important of the duties developed upon the Commissioner of Patents, there would seem to be no convincing reason why Congress might not have established the Patent Office as a separate and independent, special, judicial tribunal for the investigation of the claims of inventors, and the adjudication of their rights as against the public at large, or adverse claimants of the same invention. Had it seen proper so to do it might then have given, or denied, the right of review to any of the courts of general jurisdiction created by or under Section 1, of Article 3 of the Constitution. In *Murray v. Hoboken Land & Imp. Co.* 18 How. 272, 284, which was a case involving the validity of a sale of land made by a United States Marshal, under a distress warrant issued by the Solicitor of the United States Treasury against a Collector of Customs, for a debt due the United States, Mr. Justice Curtis, speaking for the entire court, said: "To avoid misconstruction upon so grave a subject, we think it proper to state that we do not consider Congress can either withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty; nor, on the other hand, can it bring under the judicial power a matter which, from its nature, is not a subject for judicial determination. At the same time there are matters, involving public rights, which may be presented in such form that the judicial power is capable of acting on them, and which are susceptible of judicial interpretation, but which Congress may or may not bring within the cognizance of the courts of the United States, as it may deem proper".

The Court of Private Land Claims established, for a limited period, by the Act of March 3, 1891 (26 Stat. 854) is a special tribunal of the kind referred to above; and the act creating it and giving the right of appeal therefrom to the Supreme Court of the United States has been upheld by that court. *U. S. v. Coe* 155 U. S. 76, 85. In that case it was said by the Chief Justice: "It must be regarded as settled that Section 1 of Article III does not exhaust the power of Congress to establish courts".

Before the creation of the Court of Claims in 1855 there was no way in which the justice of a claim or demand against the United States could be judicially ascertained and established. Congress might recognize and pay them, or not, according to its own view of justice and legality in the premises. It could, and did, also, submit claims to investigation, allowance and payment by the officers of the executive department. Recognizing the justice and expediency of providing a regular tribunal wherein claims against the United States might be investigated, heard and determined, in accordance with the forms of law, the Court of Claims was created and vested with jurisdiction in certain cases of the kind, the scope of which has been increased from time to time. The claims submitted to adjudication were such as no court could take jurisdiction of without the express consent of Congress, because the controversy was with the government. The forms of procedure excluded trial by jury. Appeals taken to the Supreme Court of the United States were determined upon questions of law arising on the findings of fact made by the court. At the same time, by special enactment, any appeal could be made determinable upon both facts and law as in equity cases. *Harvey v. U. S.* 105 U. S. 671, 691.

Referring to a provision of the act of March 3, 1863, conferring power on the Court of Claims to render judgment against a claimant upon any plea of set-off, counter claim, and so forth, offered by the United States, without trial by jury, Mr. Justice Harlan said: "There is nothing in these provisions which violates either the letter or spirit of the Seventh Amendment. Suits against the government in the Court of Claims, whether reference be had to the claimants demand, or to the defence, or to any set-off, or counter claim which the government may assert, are not controlled by the Seventh Amendment. They are not suits at common law within its true meaning. The government can not be sued, except with its own consent. It can declare in what court it may be sued, and prescribe the forms of pleading and the rules of practice to be observed in such suits. It may restrict the jurisdiction of the court to a consideration of only certain classes of claims against the United States". *McElrath v. U. S.* 102 U. S. 426, 440.

In *Gordon v. U. S.* 2 Wall. 561; *S. C.* 117 U. S. (Appendix) 697, which is one of the cases strongly relied on by the appellant, the majority of the court refused to entertain an appeal from the Court of Claims. The appeal was dismissed on the ground that Congress could not authorize or require the Supreme Court "to express an opinion on a case where its judicial power could not be exercised, and where its judgment would not be final and conclusive upon the rights of the parties, and process of execution awarded to carry it into effect". *In re Sanborn*, also, (148 U. S. 222, 226) the Court held that it had no jurisdiction to entertain an appeal from the Court of Claims because the act authorizing the transmission of the claim for investigation by that court, required its report to be made to the head of the department transmitting the claim, for his information, without being binding upon him. Finding this to be the meaning of the act, the court said: "We regard the function of the Court of Claims, in such a case, as ancillary and advisory, merely. The finding or conclusion reached by that court is not enforceable by any process of execution issuing from the court, nor is it made, by the statute, the final and indisputable basis of action either by the department or by Congress. It is therefore within the scope of the decision of *Gordon v. United States*". After referring to the cases of *U. S. v. Yale Todd* and *U. S. v. Ferreira*, 13 How. 52; wherein the action required of the District Judge, in certain cases, amounted, not to a judgment, but to a mere award, subject to be reviewed by the Secretary of the Treasury, Mr. Justice Shiras, speaking for the court in the same case, (p. 225) said: "Afterwards, and perhaps in view of the conclusion reached by the court in those cases, on March 17, 1866, Congress passed an act giving an appeal to the Supreme Court from judgments of the Court of Claims, and repealing those provisions of the act of March 3, 1863, which practically subjected the judgments of the Supreme Court to the re-examination and revision of the departments, and since that time no doubt has been entertained that the Supreme Court can exercise jurisdiction on appeal from final judgments of the Court of Claims. *U. S. v. Alire* 6 Wall. 573; *U. S. v. O'Grady* 22 Wall. 641; *U. S. v. Jones* 119 U. S. 477".

In an article by Mr. Edward B. Whitney in the Yale Law Review (October 1896) entitled—Federal Judges and Quasi Judges, to which we are much indebted, the various phases of this vexed question, as suggested in the acts of Congress and decisions thereunder, are discussed in an interesting and instructive manner. After quoting from the opinion of Chief Justice Taney in *Gordon v. U. S.* he says: "A hearing and decision by such a court is strictly judicial in its nature when Congress does permit the United States to be sued; and when its decision is unreviewable by the executive it may be made reviewable by the Supreme Court. Hence, although the Chief Justice rightly said that the Supreme Court's power "is exclusively judicial, and it cannot be required or authorized to exercise any other", nevertheless that court for thirty years past has had and constantly exercised power to review decisions of the Court of Claims when appealed; and by the recent Tucker Act (March 3, 1887) the Circuit and District Courts of the United States now exercise a jurisdiction concurrent with that of the Court of Claims". Turning to later legislation concerning controversies between the government and private persons he says: "Another *quasi*-judicial tribunal, passing upon questions as to which the United States are parties interested, is the Board of General Appraisers sitting at New York. The decisions of this Board as to the valuation of imported goods are final; upon questions of classification they are subject to review by the courts. Their opinions are printed in the Treasury publication entitled Synopsis of Decisions".

In the recent case of *Interstate Commerce Commission v. Brimson* (154 U. S. 447), where the majority of the court sustained the validity of the 12th section of the Interstate Commerce Act authorizing the Circuit Courts to use their process in aid of inquiries before that Commission, the question as to how far Congress, in the execution of other express powers, can go in imposing upon the Courts of the United States duties in aid of an executive or administrative body, was again exhaustively discussed in both the opinion of the court and the dissenting opinion of Mr. Justice Brewer. Mr. Justice Harlan delivering the opinion for the majority, after a careful statement of the doctrine of the cases of Hay-

burn, Yale Todd, Ferreira and Gordon, upon which the appellant here relies, said: "The views we have expressed in the present case are not inconsistent with anything said or decided in those cases". 154 U. S. p. 485. Again he says, referring to the aid of the court as therein invoked, (p. 487), "The present proceeding is not merely ancillary and advisory. It is not as in *Gordon's case*, one in which the United States seek from the Circuit Court of the United States an opinion that "would remain a dead letter and without any operation upon the rights of the parties". The proceeding is one for determining rights arising out of specified matters in dispute that concern both the general public and the individual defendants". Discussing the nature of this determination he says: "It is none the less the judgment of a judicial tribunal dealing with questions judicial in their nature, and presented in the customary forms of judicial proceedings, because its effect may be to aid an administrative or executive body in the performance of duties legally imposed upon it by Congress in execution of a power granted by the Constitution".

Under the authority of that case a District Judge has been compelled by *mandamus* to compel the attendance of witnesses before special examiners of the Pension Bureau in aid of an investigation of a claim therein. *In re Lochren* 163 U. S. 692.

It can not be claimed that the decision invoked by appeal from the Commissioner of Patents to this Court is not final and conclusive in the matter. "The Commissioner can not question it. He is bound to record and obey it. His failure or refusal to execute it by appropriate action would undoubtedly be corrected and supplied by suitable judicial process. The decree of the court is the final adjudication upon the question of right; every thing after that dependent upon it is merely in execution of it; it is no longer matter of discretion, but has become imperative and enforceable. It binds the whole department, the Secretary as well as the Commissioner, for it has settled the question of title, so that a demand for the signatures necessary to authenticate the formal instrument and evidence of grant may be enforced". *Butterworth v. Hoe* 112 U. S. p. 60.

Then, if Congress, which seems clear, could have created

a distinct, special tribunal, proceeding after the manner of a court of law or equity, for the adjudication of claims to patents to inventions, there would seem to be no convincing reason why it could not, without violating the Constitution, make it a branch or bureau of an executive department, subject to supervision, in matters administrative only, by the head of that department, and subject to review, in matters judicial in their nature, by a court of competent jurisdiction.

The Constitution simply declares that: "The executive power shall be vested in a President of the United States of America". By Act of Congress, certain executive departments have been created to aid the President in the performance of his duties and to act by his authority. That there may be a distinct line of separation between the duties with which an executive department is charged is clearly stated by Chief Justice Marshall in *Marbury v. Madison* (1 Cranch 137, 166) from whom we quote: "In such cases their acts are his acts; and whatever opinion may be entertained of the manner in which executive discretion may be used, still there exists, and can exist, no power to control that discretion. The subjects are political. They respect the nation, not individual rights, and being intrusted to the executive, the decision of the executive is conclusive

\* \* \* But when the legislature proceeds to impose on that officer other duties; when he is directed peremptorily to perform certain acts; when the rights of individuals are dependent on the performance of those acts; he is so far the officer of the law; is amenable to the laws for his conduct; and can not at his discretion sport away the vested rights of others. The conclusion from this reasoning is, that where the heads of departments are the political or confidential agents of the executive, merely to execute the will of the president, or rather to act in cases in which the executive possesses a constitutional or legal discretion, nothing can be more perfectly clear than that their acts are only politically examinable. But when a specific duty is assigned by law, and individual rights depend upon the performance of that duty, it seems equally clear that the individual who considers himself injured, has a right to resort to the laws of his country for a remedy". The pro-

priety then of judicial interference seems determinable "not by the office of the person, but the nature of the thing to be done". Idem p. 170. It was in view of such a distinct division between the two classes of duties imposed upon the Commissioner of Patents by the Acts of Congress that the conclusion was reached in *Butterworth v. Hoe*. The supervision of the Secretary of the Interior was held in that case to be limited to matters purely administrative; matters judicial in their investigation and determination were declared to be under the supervision of the courts. "It is not consistent", said Mr. Justice Matthews, "with the idea of judicial action that it should be subject to the direction of a superior, in the sense in which that authority is conferred upon the head of an executive department in reference to his subordinates."

Without further prolonging the discussion of this interesting question and admitting that we are not without doubt in respect of the soundness of our judgment, we repeat that we have not been able to see our way to the conclusion urged upon us; namely, that the act conferring the right of appeal to this court from the decisions of the Commissioner of Patents is beyond the power of Congress to enact, for the reason that it oversteps the boundaries erected by the Constitution between the three great departments of the government.

The judgment will therefore be affirmed with costs; and it is so ordered.

*Affirmed.*

SETH SHEPARD,  
Associate Justice.

Endorsed : No. 603. The U. S. ex rel. Alfred L. Bernardin, appellant vs. John S. Seymour, Commissioner of Patents. Opinion of the Court per Mr. Justice Shepard. Court of Appeals, District of Columbia, Filed Mar. 1, 1897, Robert Willett, Clerk.

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Test: ROBERT WILLETT

[SEAL]

Clerk.